IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS & INTERFERENCES

In re Patent Application of: William J. Jones et al	Customer No.: 41230
Application No.: 09/967,232	Confirmation No.: 1787
Filed: September 28, 2001	Art Unit: 3653
For: SYSTEM AND METHOD FOR PROCESSING CURRENCY BILLS AND SUBSTITUTE CURRENCY MEDIA IN A SINGLE DEVICE	Examiner: J. A. Shapiro

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APPEAL BRIEF

Sir:

The following Appeal Brief is submitted in support of the appeal proceedings instituted by a Notice of Appeal filed March 24, 2009, in response to the final Office Action mailed December 18, 2008 (Exhibit C) and the Advisory Action mailed March 6, 2009 (Exhibit A) in connection with the above-captioned patent application.

I.   REAL PARTY IN INTEREST

Cummins-Allison Corp. is the real party in interest.

II.   RELATED APPEALS AND INTERFERENCES

There are presently no appeals or interferences known to the Appellants, the Appellants' representative, or the assignee, which will directly affect, or be directly affected by, or have a bearing on the Board's decision in the pending appeal.

III.   STATUS OF CLAIMS

Claims 1-7 and 11-89 are currently pending in the application. Claims 7, 13, 14, 16, 21, 30-32, 34, 37, 41-48, 57, 58, 60-64, 66, 67, 69-78, 81-86, and 88 have been withdrawn. Claims 8-10 and 90-111 have been cancelled. This Appeal is taken from the rejection of claims 1-6, 11, 12, 15, 17-20, 22-29, 33, 35, 36, 38-40, 49-56, 59, 65, 68-70, 79, 80, 87, and 89, as submitted in the Appendix herewith.

IV.   STATUS OF AMENDMENTS

No amendments to the claims have been entered subsequent to the final Office Action mailed on December 18, 2008 (hereinafter, "final Office Action") (Exhibit C).

According to the Advisory Action mailed March 6, 2009 (hereinafter, "Advisory Action") (Exhibit A), the Examiner did not enter the amendments to the claims filed by Applicants on February 18, 2009 in the Amendment and Response to Final Office Action Dated December 18, 2008 (hereinafter "Amendment After Final") (Exhibit B). In the final Office Action, the Examiner rejected claims 1-7 under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. (*See* final Office Action, page 2, lines 9-11.) Specifically, the Examiner asserts: "It is not clear whether the return receptacle is

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'configured' to return substitute funds. The return receptacle does not effect 'returning' substitute funds, but instead only recites a receptacle that holds a stack of mixed currency and currency substutes [sic]." (*See id.*, page 2, lines 12-14.) Applicants addressed the rejection under 35 U.S.C. § 112, second paragraph, by amending independent claim 1 in the Amendment After Final. In particular, Applicants amended claim 1 to recite "a return receptacle coupled to the processing module and configured to receive return the processed substitute funds which are returned to the operator of the funds processing machine." (*See* Amendment After Final, page 2, lines 3-15; page 17, lines 17-23.) However, in the Advisory Action, the Examiner marked the checkboxes indicating "3. The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will <u>not</u> be entered because (c) They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issued for appeal." (*See* Advisory Action, Cover Page.) In addition, the Examiner marked the checkboxes indicating "7. For purposes of appeal, the proposed amendment(s): a) will not be entered." (*See id.*) Applicants respectfully maintain that the amendment to claim 1 should have been entered as the amendment 1) places the application either in condition for allowance or in better form for appeal; 2) raises no new issue of new matter; and 3) presents no new issues requiring further consideration or search. *See* 37 CFR 1.116; *see also Manual of Patent Examining Procedure (M.P.E.P.)*, 8th Ed. § 714.12-13. To render the rejection under 35 U.S.C. § 112, second paragraph, moot and to further prosecution of this application, Applicants would agree to an Examiner's Amendment incorporating the amendment to independent claim 1 as provided in the Amendment After Final, either prior to this Honorable Board ruling on this Appeal or after the Board's ruling.

V. SUMMARY OF CLAIMED SUBJECT MATTER

The present invention is directed to a system that processes documents containing both currency bills and substitute currency media. In general, the system includes an input receptacle that receives a stack of documents containing currency bills and substitute currency media in mixed combination. The system includes a processing module or evaluation unit that processes the stack by distinguishing the currency bills from the substitute currency media in the mixed combination. The system also includes at least one output receptacle that receives the processed currency bills and/or substitute currency media.

Independent claim 1 of the present application recites a funds processing system including at least one funds processing machine in which a user inputs currency bills and substitute funds. The at least one funds processing machine comprises an input receptacle configured to receive a stack of a mixed combination of currency bills and substitute funds. (*See, e.g.,* present Specification as filed ("hereinafter, "present Specification") (Exhibit E), page 6, lines 10-11; page 7, lines 11-14; page 8, lines 3-27; page 39, line 29-page 40, line 3; and page 43, lines 8-10; *see also* element 102 of FIG. 1a; element 1200 of FIG. 12; and element 1300 of FIG. 13 (Exhibit E).) The at least one funds processing machine also comprises a processing module coupled to the input receptacle and configured to receive the currency bills and substitute funds from the stack in the input receptacle and to process the currency bills and substitute funds. (*See, e.g.,* present Specification, page 6, lines 10-12, 15-23, 26-29; page 8, lines 3-20, 24-27; page 9, lines 5-page 10, line 20, 23-25; page 13, lines 19-29; page 17, lines 9-10; page 40, lines 8-10, 28-29; and page 41, lines 7-10; *see also* elements 106, 110, 112, 114 of FIGS. 1a, b; and elements 1202, 1208 of FIG. 12.) The processing module is configured to distinguish currency bills from substitute funds and valid substitute funds from invalid substitute funds. (*See, e.g.,* present Specification, page 9, lines 7-12; page 14, lines 6-10, 16-22; page 14, line 27-page 15, line 3; page 20, line 21-page 21,

line 1; page 40, lines 10-16, 29-31; page 41, lines 10-13; and page 43, lines 11-13; *see also* elements 1204, 1208 of FIG. 12; and elements 1302, 1304 of FIG. 13.) Furthermore, the at least one funds processing machine comprises a return receptacle coupled to the processing module and configured to return the substitute funds to the operator of the funds processing machine. (*See, e.g.,* present Specification, page 6, lines 10-12; page 7, lines 13-15; page 9, lines 5-7; page 17, lines 13-22; page 19, lines 18-21; page 20, lines 25-26; page 26, lines 2-5, 9-14; page 28, lines 14-15; and page 40, lines 16-19; *see also* element 108 of FIG. 1a; elements 208a-h of FIGS. 2, 3; and element 1206 of FIG. 12.)

Independent claim 11 recites a system for processing both currency bills and substitute currency media, the system including a document processing apparatus. The document processing apparatus comprises an input receptacle configured to receive a stack of a mixed combination of currency bills and substitute currency media. (*See, e.g.,* present Specification, page 6, lines 10-11; page 7, lines 11-14; page 8, lines 3-27; page 39, line 29-page 40, line 3; and page 43, lines 8-10; *see also* element 102 of FIG. 1a; element 1200 of FIG. 12; and element 1300 of FIG. 13.) The document processing apparatus also comprises at least one output receptacle configured to receive currency bills and substitute currency media after the currency bills and substitute currency media have been evaluated. (*See, e.g.,* present Specification, page 6, lines 10-13; page 7, lines 13-15; page 9, lines 5-7; page 17, lines 13-22; page 19, lines 18-21; page 20, line 20-page 21, line 1; page 26, line 6-page 29, line 2; and page 40, lines 16-19; *see also* element 108 of FIG. 1a; elements 208a-h of FIGS. 2, 3; and elements 1206, 1212 of FIG. 12.) The document processing apparatus further comprises a transport mechanism configured to transport the currency bills and substitute currency media, one at a time, from the stack in the input receptacle to the at least one output receptacle along a transport path. (*See, e.g.,* present Specification, page 6, lines 10-12, 15-16; page 7, lines 4-10; page 13, lines 19-24; page 17, lines 12-19; page 24, line 21-page 25, line

9; page 29, lines 18-22; page 40, lines 7-9, 18-19, 28-31; and page 41, lines 7-16; *see also* element 106 of FIGS. 1a, b; element 206 of FIGS. 2, 3; elements 400, 402, 404, 406 of FIGS. 4a, b; element 606 of FIG. 6; and elements 1202, 1206, 1208, 1212 of FIG. 12.) Additionally, the document processing apparatus comprises an evaluation unit comprising at least one currency detector disposed along the transport path between the input receptacle and the output receptacle, the at least one currency detector being capable of evaluating currency bills, and a first media detector disposed along the transport path between the input receptacle and the output receptacle, the first media detector being capable of evaluating substitute currency media. (*See*, *e.g.*, present Specification, page 6, lines 10-11; page 9, line 7-page 10, line 25; page 17, lines 16-21; page 23, line 29-page 24, line 20; and page 29, lines 16-22; *see also* elements 104 of FIGS. 1a, b; element 204 of FIGS. 2, 3, 4a, b; and element 604 of FIG. 6.) The evaluating unit is configured to distinguish currency bills from substitute currency media and to distinguish valid substitute currency media from invalid substitute currency media. (*See*, *e.g.*, present Specification, page 9, lines 7-12; page 14, lines 6-10, 16-22; page 14, line 27-page 15, line 3; page 20, line 21-page 21, line 1; page 40, lines 10-16, 29-31; page 41, lines 10-13; and page 43, lines 11-13; *see also* elements 1204, 1208 of FIG. 12; and elements 1302, 1304 of FIG. 13.) Furthermore, the document processing apparatus comprises a controller coupled to the evaluation unit, the controller being configured to control the operation of the transport mechanism and the operation of the evaluation unit. (*See*, *e.g.*, present Specification, page 6, lines 16-23, 26-29; page 10, lines 18-20; and page 11, lines 22-26; *see also* element 114 of FIGS. 1a, b.)

Independent claim 56 recites a system adapted to rapidly count and evaluate currency bills and barcoded media, the barcoded media having a barcode disposed on at least one surface thereof. The system comprises an input receptacle configured to receive a stack of documents, the documents including a mixed combination of currency bills and barcoded

media. (*See, e.g.,* present Specification, page 6, lines 10-11; page 7, lines 11-14; page 8, lines 3-27; page 39, line 29-page 40, line 3; and page 43, lines 8-10; *see also* element 102 of FIG. 1a; element 1200 of FIG. 12; and element 1300 of FIG. 13.) The system also comprises at least one output receptacle configured to receive at least a portion of the stack of documents after the documents have been evaluated. (*See, e.g.,* present Specification, page 6, lines 10-13; page 7, lines 13-15; page 9, lines 5-7; page 17, lines 13-22; page 19, lines 18-21; page 20, line 20-page 21, line 1; page 26, line 6-page 29, line 2; and page 40, lines 16-19; *see also* element 108 of FIG. 1a; elements 208a-h of FIGS. 2, 3; and elements 1206, 1212 of FIG. 12.) Additionally, the system comprises a transport mechanism configured to transport the documents, one at a time, from the stack in the input receptacle to the at least one output receptacle along a transport path. (*See, e.g.,* present Specification, page 6, lines 10-12, 15-16; page 7, lines 4-10; page 13, lines 19-24; page 17, lines 12-19; page 24, line 21-page 25, line 9; page 29, lines 18-22; page 40, lines 7-9, 18-19, 28-31; and page 41, lines 7-16; *see also* element 106 of FIGS. 1a, b; element 206 of FIGS. 2, 3; elements 400, 402, 404, 406 of FIGS. 4a, b; element 606 of FIG. 6; and elements 1202, 1206, 1208, 1212 of FIG. 12.) The system further comprises an evaluation unit including a first sensor disposed along the transport path between the input receptacle and the output receptacle, the first sensor being configured to detect at least one characteristic of a currency bill, and a first barcode reader disposed along the transport path between the input receptacle and the output receptacle, the barcode reader being configured to scan a barcode. (*See, e.g.,* present Specification, page 6, lines 10-11; page 9, line 7-page 10, line 25; page 17, lines 16-21; page 23, line 29-page 24, line 20; and page 29, lines 16-22; *see also* elements 104 of FIGS. 1a, b; element 204 of FIGS. 2, 3, 4a, b; and element 604 of FIG. 6.) Moreover, the system comprises a controller coupled to the evaluation unit, the controller being configured to control the operation of the transport mechanism and the operation of the evaluation unit. (*See, e.g.,* present Specification, page 6,

lines 16-23, 26-29; page 10, lines 18-20; and page 11, lines 22-26; *see also* element 114 of FIGS. 1a, b.)

Independent claim 79 recites a document processing apparatus for processing a stack of currency bills and barcoded media. The document processing apparatus comprises an input receptacle configured to receive a stack of documents including a mixed combination of currency bills of mixed denominations and barcoded media. (*See, e.g.,* present Specification, page 6, lines 10-11; page 7, lines 11-14; page 8, lines 3-27; page 39, line 29-page 40, line 3; and page 43, lines 8-10; *see also* element 102 of FIG. 1a; element 1200 of FIG. 12; and element 1300 of FIG. 13.) The document processing apparatus also comprises a plurality of output receptacles each configured to receive at least a portion of the stack of documents. (*See, e.g.,* present Specification, page 6, lines 10-13; page 7, lines 13-15; page 9, lines 5-7; page 17, lines 13-22; page 19, lines 18-21; page 20, line 20-page 21, line 1; page 26, line 6-page 29, line 2; and page 40, lines 16-19; *see also* element 108 of FIG. 1a; elements 208a-h of FIGS. 2, 3; and elements 1206, 1212 of FIG. 12.) Additionally, the document processing apparatus comprises a transport mechanism configured to transport the currency bills and barcoded media, one at a time, from the stack in the input receptacle to one of the plurality of output receptacles. (*See, e.g.,* present Specification, page 6, lines 10-12, 15-16; page 7, lines 4-10; page 13, lines 19-24; page 17, lines 12-19; page 24, line 21-page 25, line 9; page 29, lines 18-22; page 40, lines 7-9, 18-19, 28-31; and page 41, lines 7-16; *see also* element 106 of FIGS. 1a, b; element 206 of FIGS. 2, 3; elements 400, 402, 404, 406 of FIGS. 4a, b; element 606 of FIG. 6; and elements 1202, 1206, 1208, 1212 of FIG. 12.) The document processing apparatus further comprises an evaluation unit disposed along the transport path between the input receptacle and the plurality of output receptacles, the evaluation unit comprising at least one currency sensor and a barcode reader positioned adjacent the transport path, the at least one currency sensor being configured to obtain denomination characteristic information of a

first currency bill, the barcode reader being configured to scan for a barcode on a document from the stack of documents passing along the transport path. (*See*, *e.g.*, present Specification, page 6, lines 10-11; page 9, line 7-page 10, line 25; page 17, lines 16-21; page 23, line 29-page 24, line 20; and page 29, lines 16-22; *see also* elements 104 of FIGS. 1a, b; element 204 of FIGS. 2, 3, 4a, b; and element 604 of FIG. 6.) A document on which the barcode reader detects a barcode being is termed a valid barcoded medium, and a document on which the barcode reader does not detect a barcode is termed an invalid barcoded medium. (*See*, *e.g.*, present Specification, page 14, lines 16-23; and page 40, lines 8-14; *see also* element 1204 of FIG. 12.) Moreover, the document processing apparatus comprises a controller coupled to the evaluation unit, the controller being programmable for directing currency bills having a first denomination to a specified first output receptacle of the plurality of output receptacles, and for directing a barcoded media having a valid barcode disposed thereon to a specified second output receptacle of the plurality of output receptacles. (*See*, *e.g.*, present Specification, page 6, lines 16-23, 26-29; page 10, lines 18-20; and page 11, lines 22-26, page 19, lines 1-21; and page 20, lines 20-26; *see also* elements 114, 116 of FIG. 1a; and element 216 of FIG. 2.) The document processing apparatus also comprises a memory electrically coupled to the controller, the memory being configured to store the denominations of the currency bills and the characters associated with barcodes on barcoded media. (*See*, *e.g.*, present Specification, page 14, lines 23-26; and page 43, lines 13-20; *see also* elements 1306 and 1308 of FIG. 13.)

Independent claim 87 recites a document processing apparatus adapted to process currency bills and substitute currency media. The document processing apparatus comprises an input receptacle configured to receive a stack of documents including a mixed combination of currency bills and substitute currency media, the substitute currency media being redeemable documents. (*See*, *e.g.*, present Specification, page 6, lines 10-11; page 7,

lines 11-14; page 8, lines 3-27; page 39, line 29-page 40, line 3; and page 43, lines 8-10; *see also* element 102 of FIG. 1a; element 1200 of FIG. 12; and element 1300 of FIG. 13.) The document processing apparatus also comprises at least one output receptacle configured to receive at least a portion of the documents after the portion of the documents have been evaluated. (*See, e.g.*, present Specification, page 6, lines 10-13; page 7, lines 13-15; page 9, lines 5-7; page 17, lines 13-22; page 19, lines 18-21; page 20, line 20-page 21, line 1; page 26, line 6-page 29, line 2; and page 40, lines 16-19; *see also* element 108 of FIG. 1a; elements 208a-h of FIGS. 2, 3; and elements 1206, 1212 of FIG. 12.) Additionally, the document processing apparatus comprises a transport mechanism configured to transport the documents, one at a time, from the stack in the input receptacle to the at least one output receptacle along a transport path. (*See, e.g.*, present Specification, page 6, lines 10-12, 15-16; page 7, lines 4-10; page 13, lines 19-24; page 17, lines 12-19; page 24, line 21-page 25, line 9; page 29, lines 18-22; page 40, lines 7-9, 18-19, 28-31; and page 41, lines 7-16; *see also* element 106 of FIGS. 1a, b; element 206 of FIGS. 2, 3; elements 400, 402, 404, 406 of FIGS. 4a, b; element 606 of FIG. 6; and elements 1202, 1206, 1208, 1212 of FIG. 12.) The document processing apparatus further comprises an evaluation unit comprising a first scanner disposed along the transport path between the input receptacle and the output receptacle, the first scanner being capable of scanning for at least one characteristic associated with a currency bill, the evaluation unit further comprising a second scanner capable of scanning for at least one characteristic associated with a substitute currency medium. (*See, e.g.*, present Specification, page 6, lines 10-11; page 9, line 7-page 10, line 25; page 17, lines 16-21; page 23, line 29-page 24, line 20; and page 29, lines 16-22; *see also* elements 104 of FIGS. 1a, b; element 204 of FIGS. 2, 3, 4a, b; and element 604 of FIG. 6.) The evaluating unit is configured to distinguish currency bills from substitute currency media and to distinguish valid substitute currency media from invalid substitute currency media.

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(*See, e.g.*, present Specification, page 9, lines 7-12; page 14, lines 6-10, 16-22; page 14, line 27-page 15, line 3; page 20, line 21-page 21, line 1; page 40, lines 10-16, 29-31; page 41, lines 10-13; and page 43, lines 11-13; *see also* elements 1204, 1208 of FIG. 12; and elements 1302, 1304 of FIG. 13.) Moreover, the document processing apparatus comprises a controller coupled to the evaluation unit, the controller being configured to control the operation of the transport mechanism and the operation of the evaluation unit. (*See, e.g.*, present Specification, page 6, lines 16-23, 26-29; page 10, lines 18-20; and page 11, lines 22-26; *see also* element 114 of FIGS. 1a, b.)

Independent claim 89 recites a document processing apparatus for processing both currency bills and redeemable documents. The document processing apparatus comprises an input receptacle for receiving a stack of a mixed combination of currency bills and redeemable documents. (*See, e.g.,* present Specification, page 6, lines 10-11; page 7, lines 11-14; page 8, lines 3-27; page 39, line 29-page 40, line 3; and page 43, lines 8-10; *see also* element 102 of FIG. 1a; element 1200 of FIG. 12; and element 1300 of FIG. 13.) The document processing apparatus also comprises a plurality of output receptacles for receiving currency bills and redeemable documents after the currency bills and the redeemable documents have been evaluated. (*See, e.g.*, present Specification, page 6, lines 10-13; page 7, lines 13-15; page 9, lines 5-7; page 17, lines 13-22; page 19, lines 18-21; page 20, line 20-page 21, line 1; page 26, line 6-page 29, line 2; and page 40, lines 16-19; *see also* element 108 of FIG. 1a; elements 208a-h of FIGS. 2, 3; and elements 1206, 1212 of FIG. 12.) Additionally, the document processing apparatus comprises a transport mechanism for transporting the currency bills and redeemable documents, one at a time, from the stack in the input receptacle to selected ones of the plurality of output receptacles along a transport path. (*See, e.g.*, present Specification, page 6, lines 10-12, 15-16; page 7, lines 4-10; page 13, lines 19-24; page 17, lines 12-19; page 24, line 21-page 25, line 9; page 29, lines 18-22; page 40,

lines 7-9, 18-19, 28-31; and page 41, lines 7-16; *see also* element 106 of FIGS. 1a, b; element

206 of FIGS. 2, 3; elements 400, 402, 404, 406 of FIGS. 4a, b; element 606 of FIG. 6; and

elements 1202, 1206, 1208, 1212 of FIG. 12.) The document processing apparatus further

comprises an evaluation unit comprising a detector disposed along the transport path between

the input receptacle and the output receptacle, the detector being configured to detect

characteristic information associated with a currency bill and characteristic information

associated with a redeemable document. (*See, e.g.*, present Specification, page 6, lines 10-11;

page 9, line 7-page 10, line 25; page 17, lines 16-21; page 23, line 29-page 24, line 20; and

page 29, lines 16-22; *see also* elements 104 of FIGS. 1a, b; element 204 of FIGS. 2, 3, 4a, b;

and element 604 of FIG. 6.) The evaluating unit is configured to distinguish currency bills

from redeemable documents and to distinguish valid redeemable documents from invalid

redeemable documents. (*See, e.g.*, present Specification, page 9, lines 7-12; page 14, lines 6-

10, 16-22; page 14, line 27-page 15, line 3; page 20, line 21-page 21, line 1; page 40, lines

10-16, 29-31; page 41, lines 10-13; and page 43, lines 11-13; *see also* elements 1204, 1208 of

FIG. 12; and elements 1302, 1304 of FIG. 13.) Moreover, the document processing system

comprises a controller coupled to the evaluation unit, the controller controlling the operation

of the transport mechanism and the operation of the evaluation unit. (*See, e.g.*, present

Specification, page 6, lines 16-23, 26-29; page 10, lines 18-20; and page 11, lines 22-26; *see*

also element 114 of FIGS. 1a, b.)

As such, the claims of the present application recite a system that advantageously

processes a stack of documents containing both currency bills and substitute currency media

in mixed combination. In particular, the system eliminates the manual sorting and separate

processing of different document types typically required to handle such a stack. (*See, e.g.*,

present Specification, page 2, line 18-page 3, line 15.) Indeed, not only does the system

eliminate the need for these time-consuming and labor-intensive tasks, the system allows the

currency bills and substitute currency media in the stack to be processed at very high rates. (*See, e.g.,* present Specification, page 17, line 26-page 18, line 2.)

VI.   GROUNDS OF REJECTION TO BE REVIEWED ON APPEAL

The grounds of rejection to be reviewed on appeal are as follows:

Claims 1-7 were rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 1, 5, 6, 11, 15, 17-20, 22-24, 33-36, 38-40, 49, 56, 59, 65, 68-70, 79, 80, 87 and 89 were rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 5,790,697 to Munro et al. (hereinafter, "Munro") in view of U.S. Patent No. 5,420,406 to Izawa et al. (hereinafter, "Izawa '406").

Claims 2-4 and 51-54 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Munro in view of Izawa '406 and further in view of U.S. Patent No. 6,264,556 to Izawa et al. (hereinafter, "Izawa '556").

Claim 12 was rejected under 35 U.S.C. § 103(a) as being unpatentable over Munro in view of Izawa '406 and further in view of U.S. Patent No. 5,620,079 to Molbak (hereinafter, "Molbak").

Claim 25 was rejected under 35 U.S.C. § 103(a) as being unpatentable over Munro in view of Izawa '406 and further in view of U.S. Patent No. 4,690,268 to Ueshin (hereinafter, "Ueshin").

Claims 26-29, 50, and 55 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Munro in view of Izawa '406, further in view of U.S. Patent No. 6,112,982 to Ahlquist et al. (hereinafter, "Alquist"), further in view of U.S. Patent No. 5,293,033 to Yamashita (hereinafter, "Yamashita"), further in view of U.S. Patent No. 5,548,110 to Storch

et al. (hereinafter, "Storch"), further in view of U.S. Patent No. 5,777,314 to Roustaei (hereinafter, "Roustaei"), and still further in view of U.S. Patent No. 6,754,636 to Walker et al. (hereinafter, "Walker").

Claims 1-6, 11, 12, 15, 17-20, 22-29, 33, 35, 36, 38-40, 49-56, 59, 65, 68-70, 79, 80, 87, and 89 were rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-73 of U.S. Patent No. 6,880,692, claims 1-78 of U.S. Patent No. 6,913,130, claims 1-91 of U.S. Patent No. 6,959,800, claims 1-31 of U.S. Patent No. 6,955,253, or claims 1-26 of U.S. Patent No. 6,868,954 in view of Izawa '406.

Claims 1-6, 11, 12, 15, 17-20, 22-29, 33, 35, 36, 38-40, 49-56, 59, 65, 68-70, 79, 80, 87, and 89 were rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1, 5, 13, 25, 26, 37, and 49 of U.S. Patent No. 7,103,438; claims 1 and 6 of U.S. Patent No. 7,201,320; claims 1-69 of U.S. Patent No. 6,843,418, claims 1-24 of U.S. Patent No. 7,146,245, or claims 14, 19, 20, 31, and 41-47 of U.S. Patent No. 7,016,767.

Claims 1-6, 11, 12, 15, 17-20, 22-29, 33, 35, 36, 38-40, 49-56, 59, 65, 68-70, 79, 80, 87, and 89 were provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 7-29, 78-89, and 146-149 of copending Application No. 09/684,103 in view of Izawa '406.

VII. ARGUMENTS

A. The rejection of claims 1-7 under 35 U.S.C. § 112, second paragraph, for indefiniteness should be REVERSED.

Claims 1-7 were rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. (*See* final Office Action, page 2, lines 9-11.) Specifically,

the Examiner asserts "It is not clear whether the return receptacle is 'configured' to return substitute funds. The return receptacle does not effect 'returning' substitute funds, but instead only recites a receptacle that holds a stack of mixed currency and currency substutes [sic]." (*Id.*, page 2, lines 12-14.) Applicants traverse the rejection, because the rejection is based on an improper reading of the claim term "return receptacle." In particular, the Examiner reads "return receptacle" to be "a receptacle that holds a stack of mixed currency and currency substitutes [sic]." (*Id.*) Nowhere in claim 1 are such limitations recited with respect to the "return receptacle." Claim 1 only recites "a return receptacle coupled to the processing module and configured to return the substitute funds to the operator of the funds processing machine." According to the *Manual of Patent Examining Procedure (M.P.E.P.)*, "the claims must be interpreted as broadly as their terms reasonably allow," and "it is important not to import in a claim limitations that are not a part of the claim." *M.P.E.P.*, 8th Ed. § 2111.01 I-II. Applicants respectfully submit that the Examiner has imported claim limitations that are not a part of the claim and that these improperly imported claim limitations form the basis of the rejection.

In addition, Applicants respectfully submit that a return receptacle can indeed be "configured to return the substitute funds to the operator of the funds processing machine." For example, the present Specification explains that "[b]y selecting various user-defined modes through the control unit 216, such as via an input device such as a keyboard 219, or a switch, button, or touch screen (not shown), the operator can direct currency bills and substitute media into specific output receptacles, such as output receptacles 208a-208h." (present Specification, page 18, lines 3-7.) In general, "the control unit 216 provides the operator with a broad range of flexibility in selecting which output receptacles receive which documents." (*Id.*, page 19, lines 4-5.) Accordingly, in one embodiment, processed substitute

media can be made available, *i.e.*, returned, to the operator via a output receptacle that is selectively configured by the control unit 216. (*See id.*, page 15, line 29-page 16, line 15.)

Moreover, even assuming that a return receptacle just receives and holds a stack of substitute funds as asserted by the Examiner, such a return receptacle would still be configured to passively return the substitute funds to the operator. Claim 1 does not recite that the return receptacle is required to actively return the substitute funds to the operator. If the Examiner reads such a requirement in claim 1, Applicants again respectfully submit that the Examiner is improperly importing claim limitations that are not a part of the claim.

In view of the foregoing, reversal of the rejection of independent claim 1 under 35 U.S.C. § 112, second paragraph, is in order and is respectfully requested. The rejection of dependent claims 2-7 under 35 U.S.C. § 112, second paragraph, is also overcome based at least on their dependency on base claim 1.

It is noted that the Applicants addressed the rejection under 35 U.S.C. § 112, second paragraph, by amending independent claim 1 in the Amendment After Final. In particular, Applicants amended claim 1 to recite "a return receptacle coupled to the processing module and configured to receive the processed substitute funds which are returned to the operator of the funds processing machine." (*See* Amendment After Final, page 2, lines 3-15; page 17, lines 17-23.) With the entry of this amendment, claim 1 would no longer recite that the return receptacle is "configured to return the substitute funds," and the rejection would be rendered moot. However, in the Advisory Action, the Examiner marked the checkboxes indicating "3. The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because (c) They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issued for appeal." (*See* Advisory Action, Cover Page.) In addition, the Examiner marked the checkboxes indicating "7. For purposes of appeal, the proposed amendment(s): a) will not be entered." (*See id.*)

Applicants respectfully maintain that the amendment to claim 1 should have been entered as the amendment 1) places the application either in condition for allowance or in better form for appeal; 2) raises no new issue of new matter; and 3) presents no new issues requiring further consideration or search. *See* 37 CFR 1.116; *see also M.P.E.P.*, § 714.12-13. To render the rejection under 35 U.S.C. § 112, second paragraph, moot and to further prosecution of this application, Applicants would agree to an Examiner's Amendment incorporating the amendment to independent claim 1 as provided in the Amendment After Final, either prior to this Honorable Board ruling on this Appeal or after the Board's ruling.

B. The rejection of claims 1, 5, 6, 11, 15, 17-20, 22-24, 33-36, 38-40, 49, 56, 59, 65, 68-70, 79, 80, 87 and 89 under 35 U.S.C. § 103(a) as being unpatentable over Munro of Izawa '406 should be REVERSED.

Claims 1, 5, 6, 11, 15, 17-20, 22-24, 33-36, 38-40, 49, 56, 59, 65, 68-70, 79, 80, 87 and 89 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Munro in view of Izawa '406. (*See* final Office Action, page 3, lines 6-8.)

The claimed invention is generally directed to a system that processes a stack of documents containing both currency bills and substitute currency media in mixed combination. In contrast to currency bills, substitute currency media refer to redeemable documents, *i.e.*, "documents that can be (a) redeemed for cash or (b) exchanged for goods or services or (c) both." (*See* present Specification, page 8, lines 3-27). For example, referring to FIG. 1a, the operator provides a mixed combination of currency bills and substitute currency media to an input receptacle 102, which are processed and delivered to one or more output receptacles 108. (*See id.*, page 7, lines 11-15.) In particular, as further illustrated by the example of FIG. 1a, a transport mechanism 106 transports the documents from the stack at the input receptacle 102, one at a time, past a currency detector 110 and a media detector

112 to detect the currency bills and the substitute currency media. (*See id.*, page 9, lines 5-7.) The currency detector 110 detects one or more predetermined characteristics on a currency bill, and the media detector 112 detects one or more predetermined characteristics on a particular kind of substitute currency medium, such as a barcode on a barcoded ticket. (*See id.*, page 9, lines 7-12.)

Because the claimed invention can process a stack of documents containing both currency bills and substitute currency media in mixed combination, the claimed invention eliminates the manual sorting and separate processing of differing document types typically required to handle such a stack. (*See, e.g., id.*, page 2, line 18-page 3, line 15.) In addition, not only does the system eliminate the need for these time-consuming and labor-intensive tasks, the system allows the currency bills and substitute currency media in the stack to be processed at very high rates. (*See, e.g., id.*, page 17, line 26-page 18, line 2.)

Accordingly, independent claim 1 of the present application generally recites a funds processing system including at least one funds processing machine in which a user inputs currency bills and substitute funds. Independent claim 11 generally recites a system for processing both currency bills and substitute currency media, the system including a document processing apparatus. Independent claim 56 generally recites a system adapted to rapidly count and evaluate currency bills and barcoded media, the barcoded media having a barcode disposed on at least one surface thereof. Independent claim 79 generally recites a document processing apparatus for processing a stack of currency bills and barcoded media. Independent claim 87 generally recites a document processing apparatus adapted to process currency bills and substitute currency media. Independent claim 89 generally recites a document processing apparatus for processing both currency bills and redeemable documents.

1. The combination of Munro and Izawa '406 fails to teach or suggest each and every element recited by independent claims 1, 11, 56, 79, 87, and 89.

One basic requirement for a prima facie case of obviousness under 35 U.S.C. § 103(a) is that the prior art references must teach or suggest each and every element recited by the claims. *See*, *e.g.*, *M.P.E.P.* § 2143. "All words in a claim must be considered in judging the patentability of that claim against the prior art." *M.P.E.P.* § 2143.03 (citing *In re Wilson*, 424 F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA 1970)). Applicants respectfully request that the rejection of the claims under 35 U.S.C. § 103(a) be reversed, because neither Munro nor Izawa '406 teaches or suggests an input receptacle that receives a stack of a mixed combination of both currency bills and documents of another type, as recited by independent claims 1, 11, 56, 79, 87, and 89.

In particular, independent claim 1 recites, *inter alia*, "an input receptacle configured to receive a stack of a mixed combination of currency bills and substitute funds."

Independent claim 11 recites, *inter alia*, "an input receptacle configured to receive a stack of a mixed combination of currency bills and substitute currency media."

Independent claim 56 recites, *inter alia*, "an input receptacle configured to receive a stack of documents, the documents including a mixed combination of currency bills and barcoded media."

Independent claim 79, *inter alia*, recites "an input receptacle configured to receive a stack of documents including a mixed combination of currency bills of mixed denominations and barcoded media."

Independent claim 87, *inter alia*, recites "an input receptacle configured to receive a stack of documents including a mixed combination of currency bills and substitute currency media, the substitute currency media being redeemable documents."

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Independent claim 89, *inter alia*, recites "an input receptacle for receiving a stack of a mixed combination of currency bills and redeemable documents."

The Examiner asserts that "Munro discloses a document processing apparatus (10) that processes stacks of currency placed in an input receptacle (12) in mixed denominations . . . ." (final Office Action, page 3, lines 9-11.) According to the Examiner's reading, Munro discloses an input receptacle receiving stacks of only mixed denominations of currency bills and fails to teach or suggest an input receptacle that receives a mixed combination of both currency bills and documents of another type. Indeed, the Examiner, for example, acknowledges that "Munro does not expressly disclose . . . processing both barcoded documents as well as paper currency." (*Id.*, page 4, lines 4-8.)

To cure the deficiency of Munro, the Examiner asserts that "Izawa discloses an evaluation unit having both a validator/discriminator (10) and a barcode reader (24, 25), in which the controller converts a signal generated by the barcode reader into a set of characters, for the purpose of processing both barcoded documents as well as paper currency." (*Id.*, page 3, lines 5-8.) Izawa '406, however, fails to disclose an input receptacle that receives a stack of a mixed combination of barcoded documents and paper currency. Rather, Izawa '406 teaches "a bill validator 10 and a stacker 11 mounted on the bill validator to [be] connected therewith by a passageway 13 to transport a bill to be inserted from an inlet 12 to an outlet 14." Izawa '406, column 3, lines 56-59. As shown in FIG. 1, the inlet 12 is merely a slot that cannot accommodate a stack of a mixed combination of barcoded documents and paper currency. Indeed, Izawa '406 explains that "a bill," *i.e.*, a single bill, rather than a stack of bills, is provided at the inlet 12. *Id.*, column 3, lines 58-59.

Furthermore, referring to FIG. 4, Izawa '406 states:

> When the inserted bill is not genuine in Step 59 or when the bill is not any one
> of the predetermined money kinds in Step 61, the processing is moved to Step

73 wherein the CPU 40 drives the conveyor motor 42 in the reverse direction, and the bill is returned to the inlet [12].

Id., column 6, lines 35-40. Thus, Izawa '406 teaches that when a problem is detected with a bill, the bill is returned to the inlet 12 where it was initially inserted. To enable the bill handling apparatus of Izawa '406 to operate according to this teaching, the inlet 12 must remain unobstructed and available to receive a returned bill in case the bill validator 10 detects a problem with the bill. As such, no other bills, such as a stack of bills, can be positioned at the inlet 12 during processing, because these other bills would block a returned bill from passing through the inlet 12. Because a single bill, at most, can be provided at the inlet 12 when the bill handling apparatus is not still processing another bill, Izawa '406 fails to even contemplate providing a stack of any combination of documents at the inlet 12.

Thus, like Munro, Izawa '406 fails to teach or suggest a document processing apparatus having an input receptacle configured to receive a stack of a mixed combination of currency bills and documents of another type. As such, the references fail to teach or suggest each and every element of the independent claims and thus cannot provide sufficient grounds for establishing a *prima facie* case of obviousness. Indeed, even assuming that the teachings of Munro and Izawa '406 are combinable as suggested by the Examiner, the result of the combination would merely yield an apparatus that receives a stack of currency bills and not a mixed combination of currency bills and documents of another type, because the only stack of documents disclosed by either reference is the stack of currency bills taught by Munro.

Accordingly, reversal of the rejection of independent claims 1, 11, 56, 79, 87, and 89 is in order and is respectfully requested. According to the *M.P.E.P.*, "[i]f an independent claim is nonobvious under 35 U.S.C. 103, then any claim depending therefrom is nonobvious." *M.P.E.P.* § 2143.03 (citing *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988)). Therefore, claims 5, 6, 15, 17-20, 22-24, 33-36, 38-40, 49, 59, 65, 68, and 80 are

also allowable based at least on their dependency on claims 1, 11, 56, and 79. Applicants note that dependent claims 69 and 70, which the Examiner rejected, were previously withdrawn.

2. The teachings of Munro and Izawa '406 cannot be combined without modifying the principle of operation of one of the references.

According to the *M.P.E.P.*, "[i]f the proposed modification or combination of the prior art would change the principle of operation of the prior art invention being modified, then the teachings of the references are not sufficient to render the claims prima facie obvious." *M.P.E.P.* § 2143.01 VI. Applicants respectfully request that the rejection of the claims under 35 U.S.C. § 103(a) be reversed, because combining the teachings of Izawa '406 and Munro as suggested by the Examiner would improperly require the principle of operation of one of the references to be modified.

Although Munro may disclose "an input receptacle or bill accepting station 12 where stacks of currency bills that need to be identified and counted are positioned" (Munro, column 27, lines 46-48), the apparatus of Munro cannot be combined with the teachings of Izawa '406 to achieve the claimed invention, because the teachings of Izawa '406 prohibit the input receptacle from having a stack of bills. In particular, as discussed previously, Izawa '406 discloses an inlet 12 that is merely a slot for receiving a single bill and that cannot accommodate a stack of a mixed combination of barcoded documents and paper currency. *See, e.g.,* Izawa '406, column 3, lines 56-59; FIG. 1. In addition, Izawa '406 teaches that when a problem is detected with a bill, the bill is returned to the inlet 12 where it was initially inserted. *See id.,* column 6, lines 35-40. Thus, to enable the bill handling apparatus of Izawa '406 to operate according to this teaching, no other bills, such as a stack of bills, can be positioned at the inlet 12 during processing, because these other bills would block a returned bill from passing through the inlet 12. Because a single bill, at most, can be provided at the

inlet 12 when the bill handling apparatus is not still processing another bill, the teachings of Izawa '406 are incompatible with the use of the input receptacle 12 by Munro. In other words, modifying Munro to operate with the inlet 12 required by Izawa '406 would change the principle of operation of Munro's input receptacle. Conversely, the bill handling apparatus of Izawa '406 cannot be modified to include an input receptacle having a stack of bills as taught by Munro, because the stack of bills would prevent a bill from being returned through the inlet 12 and would change the principle of operation of the apparatus of Izawa '406.

Furthermore, as Munro explains, "[i]n one embodiment, bills are scanned and identified at a rate in excess of 800 bills per minute." Munro, column 27, lines 54-56. Employing the input receptacle 12 of Munro to receive stacks of currency bills is particularly appropriate for the automated embodiments of Munro which process bills at such a high rate. However, the bill handling apparatus of Izawa '406 cannot process bills at a high rate, because it can only accommodate one bill at a time. *See* Izawa '406, column 3, lines 58-59. If multiple bills were inserted through the inlet 12 to be in the passageway 13 at the same time, the apparatus would be unable to return a bill to the inlet 12 without interference from other bills in the passageway 13, and the movement of the conveyor means 16 in the reverse direction would interfere with the processing of the other bills. *See id.*, column 6, lines 35-40. Thus, additional bills cannot be received by the passageway 13 until a preceding bill is completely processed and there is no chance that the bill will be returned. Moreover, the processing of each bill must be individually monitored in case a bill is returned to the inlet 12, so that a returned bill can be removed from the inlet 12 to allow other bills to be inserted into the inlet 12. Because Izawa '406 employs an approach that accommodates one bill at a time and that may even require manual intervention, the apparatus of Munro cannot be combined with the teachings of Izawa '406 without losing the ability to process bills at a high

rate in an automated manner. Again, such a modification would change the principle of operation of Munro's apparatus.

Because Munro and Izawa '406 disclose extremely different approaches for processing bills, combining the teachings of Izawa '406 and Munro as suggested by the Examiner would require the principle of operation of one of the references to be modified. Accordingly, the teachings of Munro and Izawa '406 are not combinable to establish sufficient grounds for a *prima facie* case of obviousness. Therefore, reversal of the rejection of claims 1, 5, 6, 11, 15, 17-20, 22-24, 33-36, 38-40, 49, 56, 59, 65, 68, 79, 80, 87 and 89 is in order and is respectfully requested. Applicants note again that dependent claims 69 and 70, which the Examiner rejected, were previously withdrawn.

3. **Rejecting the claims based on the combination of Munro and Izawa '406 is the result of impermissible hindsight.**

According to the *M.P.E.P.*, "impermissible hindsight must be avoided and the legal conclusion must be reached on the basis of the facts gleaned from the prior art." *M.P.E.P.* § 2142. As discussed previously, neither Munro nor Izawa '406 teaches or suggests an input receptacle that receives a stack of a mixed combination of both currency bills and documents of another type, as recited by independent claims 1, 11, 56, 79, 87, and 89. Moreover, as also discussed previously, combining the teachings of Izawa '406 and Munro as suggested by the Examiner would improperly require the principle of operation of one of the references to be modified. The Examiner's attempt to stretch the teachings of Munro and Izawa '406 to arrive at the claimed invention where such teachings fail to exist strongly suggests that the Office Action is applying impermissible hindsight.

Indeed, the Examiner explains: "At the time of the invention, it would have been obvious to one of ordinary skill in the art to have incorporated a barcode reader in Munro's evaluation device, as taught by Izawa, for the purpose of handling barcoded documents

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placed in the same stack of documents as paper currency." (final Office Action, page 4, lines 10-13.) Applicants respectfully submit that the Examiner's reason for combining Munro and Izawa '406 is conclusory and the Examiner has provided absolutely no evidence that this reasoning is based on anything but impermissible hindsight. The courts have established that the reasoning behind an obviousness rejection "should be made explicit." *KSR Int'l Co. v. Teleflex Inc.*, 127 S. Ct. 1727, 1741 (2007) (citing *In re Kahn*, 441 F.3d 977, 988 (Fed. Cir. 2006) ("[R]ejections on obviousness grounds cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness.")); *see also M.P.E.P.* § 2142. In this case, however, the Examiner provides absolutely no explicit reasoning or support for concluding that it would have been obvious for one of ordinary skill in the art to incorporate a barcode reader in Munro's evaluation device. As described previously, neither Munro nor Izawa '406 contemplate processing a stack of a mixed combination of both currency bills and documents of another type, and there is no reason to apply their teachings to solve the problem solved by the claimed invention.

Accordingly, Applicants respectfully request that the rejection of the claims under 35 U.S.C. § 103(a) be reversed. Reversal of the rejection of claims 1, 5, 6, 11, 15, 17-20, 22-24, 33-36, 38-40, 49, 56, 59, 65, 68, 79, 80, 87 and 89 is in order and is respectfully requested. Applicants note again that dependent claims 69 and 70, which the Examiner rejected, were previously withdrawn.

4. The combination of Munro and Izawa '406 fails to teach or suggest each and every element recited by dependent claims 5, 6, 23, and 24.

As discussed previously, one basic requirement for a prima facie case of obviousness under 35 U.S.C. § 103(a) is that the prior art references must teach or suggest each and every element recited by the claims. See, *e.g.*, *M.P.E.P.* § 2143. Applicants respectfully request

that the rejection of dependent claims 5, 6, 23, and 24 under 35 U.S.C. § 103(a) be reversed, because neither Munro nor Izawa '406 teaches or suggests processing substitute funds or substitute currency media at a high rate of speed, as recited by claims 5, 6, 23, and 24.

In particular, dependent claim 5 recites: "The system of claim 1, wherein the processing module is configured to scan and count the currency bills and substitute funds at a high rate of speed."

Dependent claim 6 recites: "The system of claim 5, wherein the high rate of speed is at least 350 documents per minute."

Dependent claim 23 recites: "The apparatus of claim 11 wherein the evaluation unit evaluates the currency bills and substitute currency media at a rate of at least about 1000 documents per minute."

Dependent claim 24 recites: "The apparatus of claim 11 wherein the evaluation unit evaluates the currency bills and substitute currency media at a rate of at least about 1500 documents per minute."

As described previously, the Examiner asserts that "Munro discloses a document processing apparatus (10) that processes stacks of currency placed in an input receptacle (12) in mixed denominations . . . ." (final Office Action, page 3, lines 9-11.) According to the Examiner's reading, Munro's teachings relate only to the processing of currency bills. Indeed, the Examiner, for example, acknowledges that "Munro does not expressly disclose . . . processing both barcoded documents as well as paper currency." (*Id.*, page 4, lines 4-8.)

To cure the deficiency of Munro, the Examiner asserts that "Izawa discloses an evaluation unit having both a validator/discriminator (10) and a barcode reader (24, 25), in which the controller converts a signal generated by the barcode reader into a set of characters, for the purpose of processing both barcoded documents as well as paper currency." (*Id.*, page

3, lines 5-8.) Thus, the Examiner relies on Izawa '406 to establish any teachings relating to substitute funds or substitute currency media, such as barcoded documents. However, as described previously, the bill handling apparatus of Izawa '406 cannot process bills at a high rate, because it can only accommodate one bill at a time. *See* Izawa '406, column 3, lines 58-59. In particular, if multiple bills were inserted through the inlet 12 to be in the passageway 13 at the same time, the apparatus of Izawa '406 would be unable to return a bill to the inlet 12 without interference from other bills in the passageway 13, and the movement of the conveyor means 16 in the reverse direction would interfere with the processing of the other bills. Thus, additional bills cannot be received by the passageway 13 until a preceding bill is completely processed and there is no chance that the bill will be returned. In addition, the processing of each bill must be individually monitored in case a bill is returned to the inlet 12, so that a returned bill can be removed from the inlet 12 to allow other bills to be inserted into the inlet 12. Furthermore, assuming that the barcode readers could even be physically incorporated into the apparatus of Munro, there is absolutely no evidence that the barcode readers of Izawa '406 could operate at the high speeds taught by Munro. Because Izawa '406 employs an approach that can only accommodate one bill at a time and that may even require manual intervention, the teachings of Izawa '406 fails to teach or suggest the high rate processing of substitute funds or substitute currency media as recited by dependent claims 5, 6, 23, and 24.

Accordingly, Munro and Izawa '406 fail to teach each and every element of claims 5, 6, 23, and 24. As such, reversal of the rejection of claims 5, 6, 23, and 24 is in order and is respectfully requested.

C. **The rejection of claims 2-4 and 51-54 under 35 U.S.C. § 103(a) as being unpatentable over Munro in view of Izawa '406 and further in view of Izawa '556 should be REVERSED.**

Claims 2-4 and 51-54 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Munro in view of Izawa '406 and further in view of Izawa '556. (*See* final Office Action, page 4, lines 20-22.) One basic requirement for a prima facie case of obviousness under 35 U.S.C. § 103(a) is that the prior art references must teach or suggest each and every element recited by the claims. *See*, *e.g.*, *M.P.E.P.* § 2143. Applicants respectfully submit that dependent claims 2-4 and 51-54 are allowable because, like Munro and Izawa '406, Izawa '556 fails to teach or suggest providing an input receptacle that receives a stack of a mixed combination of both currency bills and documents of another type, as recited by their base claims 1 and 11. *See*, *e.g.*, Izawa '556, column 3, lines 53-61. In other words, Izawa '556 does not cure the deficiencies of Munro and Izawa '406 described previously. Thus, claims 2-4 and 51-54 are allowable at least for the same reasons as their base claims 1 and 11.

In addition, according to the *M.P.E.P.*, "impermissible hindsight must be avoided and the legal conclusion must be reached on the basis of the facts gleaned from the prior art." *M.P.E.P.* § 2142. Applicants respectfully submit that the Examiner's reason for combining the teachings of Munro, Izawa '406, and Izawa '556 is conclusory and the Examiner has provided absolutely no evidence that the reasoning is based on anything but impermissible hindsight. The Examiner explains:

> At the time of the invention, it would have been obvious to one of ordinary skill in the art to have processed various types of substitute funds such as casino scrip, coupons, gift certificates, and paper tokens or any other type of secure document typically used in commerce in Munro's apparatus, as taught and suggested by Izawa since Munro's device is intended to process secure documents typically used in commerce and one ordinarily skilled would have found it logical to configure the validator to accept as many formats of cash available that customers use in commerce for the purpose of promoting increased use of the machine.

(final Office Action, page 5, lines 6-13.) Although Izawa '406 may describe the use of secure paper, such as printed coupons or scrip, the Examiner's assertion that employing "many formats of cash" with the apparatus of Munro would be obvious "for the purpose of promoting increased use of the machine" (*id.*) belies the fact that Munro, Izawa '406, and Izawa '556 all fail to disclose or suggest the processing of a mixed combination of formats by a single apparatus. Moreover, because Munro, Izawa '406, and Izawa '406 all fail to contemplate processing a stack of a mixed combination of both currency bills and documents of another type, the applied references fail to indicate how employing "many formats of cash" would provide the advantage of promoting increased use of the machine as suggested by the Examiner.

Accordingly, Applicants respectfully request that the rejection of claims 2-4 and 51-54 under 35 U.S.C. § 103(a) be reversed, because Munro, Izawa '406, and Izawa '556 fail to provide sufficient grounds for the rejection.

D. **The rejection of claim 12 under 35 U.S.C. § 103(a) as being unpatentable over Munro in view of Izawa '406 and further in view of Molbak should be REVERSED.**

Claim 12 was rejected under 35 U.S.C. § 103(a) as being unpatentable over Munro in view of Izawa '406 and further in view of Molbak. (*See* final Office Action, page 5, lines 14-16.) One basic requirement for a prima facie case of obviousness under 35 U.S.C. § 103(a) is that the prior art references must teach or suggest each and every element recited by the claims. *See, e.g., M.P.E.P.* § 2143. Applicants respectfully submit that claim 12 is allowable, because like Munro and Izawa '406, Molbak fails to teach or suggest providing an input receptacle that receives a stack of a mixed combination of both currency bills and documents of another type, as recited by its base claim 11. *See, e.g.,* Molback, column 2,

lines 43-46 (describing the a device that receives and processes unsorted coins). In other words, Molbak does not cure the deficiencies of Munro and Izawa '406 described previously. Thus, claim 12 is allowable at least for the same reasons as its base claim 11. Accordingly, Applicants respectfully request that the rejection of claim 12 under 35 U.S.C. § 103(a) be reversed, because Munro, Izawa '406, and Molbak, or any combination thereof, fail to teach or suggest each and every element of the claim.

E. **The rejection of claim 25 under 35 U.S.C. § 103(a) as being unpatentable over Munro in view of Izawa '406 and further in view of Ueshin should be REVERSED.**

Claim 25 was rejected under 35 U.S.C. § 103(a) as being unpatentable over Munro in view of Izawa '406 and further in view of Ueshin. (*See* final Office Action, page 6, lines 3-5.) One basic requirement for a prima facie case of obviousness under 35 U.S.C. § 103(a) is that the prior art references must teach or suggest each and every element recited by the claims. *See, e.g., M.P.E.P.* § 2143. Applicants respectfully submit that claim 25 is allowable, because Munro, Izawa '406, and Ueshin fail to teach or suggest a "document facing mechanism being configured to rotate the orientation of the substitute currency media in one direction" as recited by claim 25. The Examiner asserts that "Munro does not expressly disclose, but Ueshin discloses incorporation of a facing mechanism (20), as illustrated in figures 2-7." (final Office Action, page 6, lines 8-9.) Ueshin, however, is generally directed to a bill sorter/stacker that only processes currency bills and does not process substitute currency media. *See, e.g.,* Ueshin, column 2, line 64-column 3, line 15. As such, the Examiner has failed to sufficiently establish how the applied references teach or suggest a facing mechanism that specifically processes substitute currency media as recited in claim 25.

In addition, Applicants respectfully submit that claim 25 is allowable because, like Munro and Izawa '406, Ueshin fails to teach or suggest providing an input receptacle that receives a stack of a mixed combination of both currency bills and documents of another type, as recited by its base claim 11. In other words, Ueshin does not cure the deficiencies of Munro and Izawa '406 described previously. Thus, claim 25 is allowable at least for the same reasons as its base claim 11.

Accordingly, Applicants respectfully request that the rejection of claim 25 under 35 U.S.C. § 103(a) be reversed, because Munro, Izawa '406, and Ueshin, or any combination thereof, fail to teach or suggest each and every element of the claim.

F. **The rejection of Claims 26-29, 50, and 55 under 35 U.S.C. § 103(a) as being unpatentable over Munro in view of Izawa '406, further in view of Alquist, further in view of Yamashita, further in view of Storch, further in view of Roustaei, and still further in view of Walker should be REVERSED.**

Claims 26-29, 50, and 55 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Munro in view of Izawa '406, further in view of Ahlquist, further in view of Yamashita, further in view of Storch, further in view of Roustaei, and still further in view of Walker. (*See* final Office Action, page 6, lines 13-17.) One basic requirement for a prima facie case of obviousness under 35 U.S.C. § 103(a) is that the prior art references must teach or suggest each and every element recited by the claims. *See, e.g., M.P.E.P.* § 2143. Applicants respectfully submit that dependent claims 26-29, 50, and 55 are allowable because, like Munro and Izawa '406, Ahlquist, Yamashita, Storch, Roustaei, and Walker all fail to teach or suggest providing an input receptacle that receives a stack of a mixed combination of both currency bills and documents of another type, as recited by their base claim 11. Rather, Ahlquist is generally directed to photographic equipment that prints

barcode indicia on photographic media. *See, e.g.*, Ahlquist, column 2, lines 7-10. Yamashita is generally directed to an optical reading apparatus having three barcode readers for providing barcode data on a single article to a point-of-sale terminal. *See, e.g.*, Yamashita, column 2, lines 50-55. Storch is generally directed to improving the reading of barcodes. *See, e.g.*, Storch, column 3, line 66-column 4, line 12. Roustaei is generally directed to optimizing the optical system within an optical scanning head for reading optically-encoded information. *See, e.g.*, column 2, lines 18-22. Walker is generally directed to a purchasing system that may employ a voucher with several barcodes each corresponding to a different retailer. *See, e.g.*, Walker, column 36, lines 46-48. Thus, Ahlquist, Yamashita, Storch, Roustaei, and Walker all disclose the processing of barcoded media, but are silent on processing currency bills in mixed combination with barcoded media. Accordingly, they fail to cure the deficiencies of Munro and Izawa '406 described previously. Thus, claims 26-29, 50, and 55 are allowable at least for the same reasons as their base claim 11.

Moreover, Applicants respectfully submit that the applied references fail to teach or suggest each and every element of claim 26 and its dependent claims 27-29. In particular, claim 26 recites:

> The apparatus of claim 11 further comprising a second media detector disposed along the transport path and proximate the at least one currency detector, wherein the first media detector is configured to detect at least one characteristic of a first type of substitute currency media and the second media detector is configured to detect at least one characteristic of a second type of substitute currency media, the first type of substitute currency media being different from the second type of substitute currency media.

The applied references fail to disclose a first media detector and a second media detector that detect characteristics corresponding to two different types of substitute currency media, respectively.

The Examiner explains:

Munro does not expressly disclose, but Ahlquist discloses incorporation of multiple barcode readers (80, 82 and 84), as illustrated in figure 3 and discussed at col. 3, lines 20-30, for the purpose of creating redundancy so as to ensure that barcodes transported along a transport mechanism are read.

(final Office Action, page 7, lines 4-7.) However, employing multiple barcode readers for the purpose of "redundancy" requires that each barcode reader read the same barcode on the same article, rather than different barcodes on different types of articles as required by claims 26-29.

In addition, the Examiner states:

Munro does not expressly disclose, but Yamashita discloses using multiple barcode readers, as illustrated in figures 1 and 2 for the purpose of ensuring the reading of barcodes located on various sides of a transport path through which the barcodes are transported.

(*Id.*, page 7, lines 8-11.) However, Yamashita generally discloses the use of multiple barcode readers to read a barcode that may be positioned on various sides of the same article. *See, e.g.*, Yamashita, column 2, line 64-column 3, line 2. As such, Yamashita fails to teach or suggest using each barcode reader to read a different type of article as required by claims 26-29.

In addition, the Examiner states:

Munro does not expressly disclose, but Roustaei discloses use of different types of barcodes, such as one, two and three-dimensional barcodes and using various readers for reading such barcodes. See abstract and col. 10, lines 7-42 of Roustaei.

(*Id.*, page 7, lines 8-11.) However, Roustaei generally discloses the configuration of barcode readers with a spatial filter having an orientation and configuration corresponding to the shape of the barcode. *See* Roustaei, column 10, lines 7-42. As such, Roustaei discloses configuring a particular barcode reader to read one type of barcode, and fails to teach or suggest arranging a plurality of barcode readers in a single device where the barcode readers each read a different type of barcode.

As applied, Storch and Walker fail to cure the deficiencies of Ahlquist, Yamashita, and Roustaei. In particular, the Examiner only cites Walker and Storch for teaching the use of multiple barcodes on a document. (*See id.*, page 7, lines 8-11.)

Accordingly, the applied references may disclose the use of multiple barcode readers or the use of multiple barcodes on a single item, but are completely silent on arranging multiple barcode readers in a document processing apparatus to read different types of substitute currency media as recited in claims 26-29.

Moreover, as discussed previously, Ahlquist is generally directed to the use of barcode readers photographic equipment, and Yamashita is generally directed to the use of barcode readers with a point-of-sale terminal. As such, Ahlquist and Yamashita are directed to the use of barcode readers in nonanalogous arts and are not related to the problem of reading a mixed combination of currency bills and substitute currency media. Thus, the Examiner has improperly included Ahlquist and Yamashita in the combination of references forming the basis for rejection. According to the *M.P.E.P.*, "In order to rely on a reference as a basis for rejection of an applicant's invention, the reference must either be in the field of applicant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the inventor was concerned.' [citations omitted]." *M.P.E.P.* § 2141.01(a) I. Indeed, including Ahlquist and Yamashita in the combination of references strongly suggests the use of impermissible hindsight in forming the basis for rejection. According to the *M.P.E.P.*, "impermissible hindsight must be avoided and the legal conclusion must be reached on the basis of the facts gleaned from the prior art." *M.P.E.P.* § 2142.

Accordingly, Applicants respectfully request that the rejection of claims 26-29, 50, and 55 under 35 U.S.C. § 103(a) be reversed, because Munro, Izawa '406, Ahlquist, Yamashita, Storch, Roustaei, and Walker, or any combination thereof, fail to provide sufficient grounds for the rejection.

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G. **The rejections of claims 1-6, 11, 12, 15, 17-20, 22-29, 33, 35, 36, 38-40, 49-56, 59, 65, 68-70, 79, 80, 87, and 89 on the ground of nonstatutory obviousness-type double patenting should be REVERSED.**

Claims 1-6, 11, 12, 15, 17-20, 22-29, 33, 35, 36, 38-40, 49-56, 59, 65, 68-70, 79, 80, 87, and 89 were rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-73 of U.S. Patent No. 6,880,692, claims 1-78 of U.S. Patent No. 6,913,130, claims 1-91 of U.S. Patent No. 6,959,800, claims 1-31 of U.S. Patent No. 6,955,253, or claims 1-26 of U.S. Patent No. 6,868,954 in view of Izawa '406.

Claims 1-6, 11, 12, 15, 17-20, 22-29, 33, 35, 36, 38-40, 49-56, 59, 65, 68-70, 79, 80, 87, and 89 were rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1, 5, 13, 25, 26, 37, and 49 of U.S. Patent No. 7,103,438; claims 1 and 6 of U.S. Patent No. 7,201,320; claims 1-69 of U.S. Patent No. 6,843,418, claims 1-24 of U.S. Patent No. 7,146,245, or claims 14, 19, 20, 31, and 41-47 of U.S. Patent No. 7,016,767.

Claims 1-6, 11, 12, 15, 17-20, 22-29, 33, 35, 36, 38-40, 49-56, 59, 65, 68-70, 79, 80, 87, and 89 were provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 7-29, 78-89, and 146-149 of copending Application No. 09/684,103 (hereinafter, "Application '103") in view of Izawa '406.

The Federal Circuit has defined the tests of double patenting as follows:

Is the same invention being claimed twice? If the answer to that is no, a second question must be asked: Does any claim in the application define merely an obvious variation of an invention claimed in the patent asserted as supporting double patenting? If the answer to that is no, *there is no double patenting.*

General Foods Corp. v. Studiengesellschaft Kohle mbH, 972 F.2d 1272, 1278, 23 U.S.P.Q.2d 1839 (Fed. Cir.), *reh'g, en banc, denied*, 1992 U.S. App. LEXIS 25713 (Fed. Cir. Oct. 5, 1992) (emphasis added); *In re Kaplan*, 789 F.2d 1574, 1579, 229 U.S.P.Q. 678 (Fed. Cir.

1986); *In re Longi*, 759 F.2d 887, 893, 225 U.S.P.Q. 645 (Fed. Cir. 1985) ("we must direct our inquiry to whether the claimed invention in the application for the second patent would have been obvious from the subject matter of the claims in the first patent, in light of the prior art"). The Federal Circuit further went on to explain the connection between obvious variation and patentable distinction stating "If the rejected claim defines *more* than an obvious variation, it is *patentably distinct*." *General Foods*, 972 F.2d. at 1278 (emphasis in original). Moreover, the Federal Circuit stated "beyond question … the determining factor in deciding whether or not there is double patenting is the existence vel non of *patentable difference* between two sets of claims." *General Foods*, 972 F.2d at 1278-79 (emphasis in original); *see also In re Sarett*, 327 F.2d 1005, 1012, 140 U.S.P.Q. 474 (C.C.P.A. 1964). Furthermore, "where the two inventions are *patentably distinct*, no disclaimer is called for." *General Foods*, 972 F.2d at 1280.

The law is clear that it is the *claims* that must be compared when assessing double patenting. *General Foods*, 972 F.2d at 1277 ("Double patenting is altogether a matter of what is claimed"); *In re Sarett*, 327 F.2d at 1007; *In re Allen*, 343 F.2d 482, 484, 145 U.S.P.Q. 147 (C.C.P.A. 1965). Furthermore, claims must be read as a whole taking into account every limitation. *General Foods*, 972 F.2d at 1278; *Id.* at 1281 ("the fundamental rule of claim construction, that what is claimed is *defined by the claim taken as a whole*, every claim limitation … being material") (emphasis in original). Furthermore, the focus is on what the claims *define*, not what they might teach. *In re Sarett*, 327 F.2d at 1013 ("We are not here concerned with what one skilled in the art would be aware from *reading* the claims but with *what inventions the claims define*") (emphasis in original); *In re Sutherland*, 347 F.2d 1009, 1014, 146 U.S.P.Q. 485 (C.C.P.A 1965) ("The 'scope' of the term 'freezing' in [the patent's] claims is not what we are concerned with but rather, *what invention* his claims *define*") (emphasis in original).

In this regard, it must be remembered that the disclosure of the prior patent is not prior art. *In re Baird*, 348 F.2d 974, 979, 146 U.S.P.Q. 579 (C.C.P.A. 1965) ("the patent disclosure is not 'prior art' and cannot be looked to for what it teaches"); *In re Sarett*, 327 F.2d at 1007. This includes the disclosure of the claims themselves. *In re Sutherland*, 347 F.2d at 1015; *General Foods*, 972 F.2d at 1281. Accordingly, the patent's specification "may be looked to to find out what the terms of the claims *mean* but that is all." *In re Baird*, 348 F.2d at 979-80; *In re Kaplan*, 789 F.2d at 1577 ("We reverse the board's double patenting rejection essentially for two reasons: ... (2) it has used the disclosure of appellants' joint invention in the Kaplan patent specification as though it were prior art, which it is not, to support the obviousness aspect of the rejection").

Applicants respectfully request that the provisional and non-provisional rejection of the claims on the ground of nonstatutory obviousness-type double patenting be reversed, because the claims of each of the cited patents/application have elements that are not present in any of the rejected claims of the present application and/or vice versa.

Moreover, the Examiner has failed to establish sufficient grounds for these provisional and non-provisional double patenting rejections of the claims, because the Examiner has not provided a proper comparison of the claims as required and has failed to offer a reasoned, fact-based explanation supported by the evidence of record to justify the rejections. *See*, *e.g.*, *Ex parte Whalen II*, Appeal 2007-4423 (B.P.A.I., July 23, 2008) (requiring a reasoned, fact-based explanation supported by the evidence of record). In particular, the Examiner's claim comparison and reasoning for each rejection is limited to a completely unorganized listing of elements that supposedly covers all the claims from all the references that form the basis of the rejection. (*See* final Office Action, page 9, lines 13-19; page 10, lines 10-18; page 11, lines 3-9.) The Examiner fails to provide any explanation of how these elements are recited in the applied references to make each one of the rejected

claims subject to an obviousness-type double patenting rejection. As such, the Examiner improperly leaves Applicants with the task of guessing how the Examiner is applying these elements to each of the rejected claims to find them obvious, making it difficult, if not almost impossible, for Applicants to respond fully to the rejections.

1. **U.S. Patent No.'s 6,880,692, 6,913,130, 6,959,800, 6,955,253, and 6,868,954 and Application No. 09/684,103 in view of Izawa '406 fail to provide sufficient grounds for the provisional and non-provisional double patenting rejection of claims 1-6, 11, 12, 15, 17-20, 22-29, 33, 35, 36, 38-40, 49-56, 59, 65, 68-70, 79, 80, 87, and 89.**

The Examiner acknowledges that "not all of the claims may have recited a 'barcode reader' that reads substitute currency." (final Office Action, page 8, lines 16-17; page 10, lines 8-9.) Thus, to cure the deficiencies in U.S. Patent No.'s 6,880,692, 6,913,130, 6,959,800, 6,955,253, and 6,868,954 and Application No. 09/684,103, the Examiner applies Izawa '406 as a secondary reference. In particular, similar to the rejection under § 103(a) described previously, the Examiner asserts that "[a]t the time of the invention, it would have been obvious to one of ordinary skill in the art to have incorporated a barcode reader in the currency processing device of [the cited patents and the copending application] for the purpose of handling barcoded documents placed in the same stack of documents as paper currency." (*Id.*, page 10, lines 1-4; page 11, lines 15-18.) However, this argument misses the mark. The issue is whether the pending claims *claim* inventions which are obvious variant of *what is claimed* in another patent. Such is not the case.

Furthermore, as described previously, the barcode reader of Izawa '406 is not combinable with a device that receives a stack of currency bills via an input receptacle. The apparatus of Izawa '406 employs an inlet that is merely a slot and that cannot accommodate a

stack of a mixed combination of barcoded documents and paper currency. *See* Izawa '406,

column 3, lines 58-59. In addition, no other bills, such as a stack of bills, can be positioned at

the inlet 12 during processing, because Izawa teaches that when a problem is detected with a

bill, the bill is returned to the inlet 12 where it was initially inserted. *See id.*, column 6, lines

35-40. Thus, additional bills cannot be received by the apparatus of Izawa '406 until a

preceding bill is completely processed and there is no chance that the bill will be returned.

Moreover, the processing of each bill must be individually monitored in case a bill is returned

to the inlet 12, so that a returned bill can be removed from the inlet 12 to allow other bills to

be inserted into the inlet 12. Because Izawa '406 employs an approach that accommodates

one bill at a time and that may even require manual intervention, Izawa '406 teaches away

from the use of "an input receptacle configured to receive a stack of a mixed combination of

currency bills and substitute funds" as recited in independent claim 1, "an input receptacle

configured to receive a stack of a mixed combination of currency bills and substitute currency

media" as recited in independent claim 11, "an input receptacle configured to receive a stack

of documents, the documents including a mixed combination of currency bills and barcoded

media" as recited in independent claim 56, "an input receptacle configured to receive a stack

of documents including a mixed combination of currency bills of mixed denominations and

barcoded media" as recited in independent claim 79, "an input receptacle configured to

receive a stack of documents including a mixed combination of currency bills and substitute

currency media" as recited in independent claim 87, and "an input receptacle for receiving a

stack of a mixed combination of currency bills and redeemable documents" as recited in

independent claim 89. Accordingly, independent claims 1, 11, 56, 79, 87, and 89 are

patentably distinct. In addition, dependent claims 5, 6, 15, 17-20, 22-24, 33-36, 38-40, 49,

59, 65, 68-70, and 80 are also distinguishable at least for the same reasons as their

corresponding base claims.

Furthermore, as described previously, there is no teaching or other evidence that the apparatus of Izawa '406 could operate at a high rate of speed in the systems recited in claim 5 and 6 or the apparatus of claims 23 and 24. Therefore, it would not have been obvious to modify U.S. Patent No.'s 6,880,692, 6,913,130, 6,959,800, 6,955,253, and 6,868,954 and Application No. 09/684,103 with the teachings of Izawa '406.

Accordingly, the teachings of Izawa '406 cannot be combined with U.S. Patent No.'s 6,880,692, 6,913,130, 6,959,800, 6,955,253, and 6,868,954 and Application No. 09/684,103 to provide sufficient grounds for a double patenting rejection. As such, the reversal of the provisional and non-provisional double patenting rejection of claims 1-6, 11, 12, 15, 17-20, 22-29, 33, 35, 36, 38-40, 49-56, 59, 65, 68, 79, 80, 87, and 89 is in order and is respectfully requested. Applicants note that dependent claims 69 and 70, which the Examiner rejected, were previously withdrawn.

2. U.S. Patent No. 7,103,438 fails to provide sufficient grounds for the double patenting rejection of claims 1-6, 11, 12, 15, 17-20, 22-29, 33, 35, 36, 38-40, 49-56, 59, 65, 68-70, 79, 80, 87, and 89.

Turning to U.S. Patent No. 7,103,438, claims 1, 5, 13, 25, 26, 37, and 49 of U.S. Patent No. 7,103,438 differ patentably from the rejected claims of the present application. To begin with, claims 1 and 5 of this patent are method claims; and thus, the rejection is improper given the previous finding that the method claims of the present application are patentably distinct from the rejected apparatus/system claims. (*See* Office Action mailed December 8, 2004 (requiring election/restrictions) (Exhibit D)). Furthermore, independent claim 1 of U.S. Patent No. 7,103,438 recites patentably distinct element(s) that are not recited in the presently rejected claims such as:

> accepting as an input at least one specific document-identifier to be searched;
> ...

determining whether a detected document-identifier matches the at least one specific document-identifier; and

directing the substitute currency medium that bears the specific document-identifier, such substitute currency medium being termed a specific document, to at least one output receptacle based on the act of determining.

Independent claim 13 of U.S. Patent No. 7,103,438 recites patentably distinct element(s) that are not recited in the presently rejected claims such as:

the controller including a memory, the memory storing instructions that determine whether a detected document-identifier matches a specific document-identifier received as an input by said controller.

Finally, the last independent of U.S. Patent No. 7,103,438 cited is independent claim 37 which recites patentably distinct element(s) that are not recited in the presently rejected claims such as:

the controller including a memory that stores a stack-identifier assigned to said first stack of documents, the memory including the document-identifier of each of the documents comprising the first stack of documents, each document-identifier being correlated with a respective stack-identifier, the memory further including instructions for determining whether a specific document-identifier inputted into said controller is located within said first stack of documents.

Additionally, the rejected claims of the present application also have patentably distinct element(s) that are not present in the cited claims of U.S. Patent No. 7,103,438. For example, independent claim 1 recites, *inter alia*:

an input receptacle configured to receive a stack of a mixed combination of currency bills and substitute funds;

a processing module coupled to the input receptacle and configured to receive the currency bills and substitute funds from the stack in the input receptacle and to process the currency bills and substitute funds, the processing module being configured to distinguish currency bills from substitute funds and valid substitute funds from invalid substitute funds

Likewise, independent claim 11 recites, *inter alia*:

an input receptacle configured to receive a stack of a mixed combination of currency bills and substitute currency media;

at least one output receptacle configured to receive currency bills and substitute currency media after the currency bills and substitute currency media have been evaluated;

a transport mechanism configured to transport the currency bills and substitute currency media, one at a time, from the stack in the input receptacle to the at least one output receptacle along a transport path;

an evaluation unit comprising at least one currency detector disposed along the transport path between the input receptacle and the output receptacle, the at least one currency detector being capable of evaluating currency bills, ... the evaluating unit being configured to distinguish currency bills from substitute currency media

Likewise, independent claim 56 recites, *inter alia*:

an input receptacle configured to receive a stack of documents, the documents including a mixed combination of currency bills and barcoded media; ...

an evaluation unit including a first sensor disposed along the transport path between the input receptacle and the output receptacle, the first sensor being configured to detect at least one characteristic of a currency bill,

Likewise, independent claim 79 recites, *inter alia*:

an input receptacle configured to receive a stack of documents including a mixed combination of currency bills of mixed denominations and barcoded media; . . .

a transport mechanism configured to transport the currency bills and barcoded media, one at a time, from the stack in the input receptacle to one of the plurality of output receptacles;

an evaluation unit disposed along the transport path between the input receptacle and the plurality of output receptacles, the evaluation unit comprising at least one currency sensor ... positioned adjacent the transport path, the at least one currency sensor being configured to obtain denomination characteristic information of a first currency bill, . . .

a controller coupled to the evaluation unit, the controller being programmable for directing currency bills having a first denomination to a specified first output receptacle of the plurality of output receptacles, . . . and

a memory electrically coupled to the controller, the memory being configured to store the denominations of the currency bills ....

Independent claim 87 recites, *inter alia*:

an input receptacle configured to receive a stack of documents including a mixed combination of currency bills and substitute currency media, . . .

an evaluation unit comprising a first scanner disposed along the transport path between the input receptacle and the output receptacle, the first scanner being capable of scanning for at least one characteristic associated with a currency

bill, ... the evaluating unit being configured to distinguish currency bills from substitute currency media and to distinguish valid substitute currency media from invalid substitute currency media; ....

And finally, independent claim 89 recites, *inter alia*:

> an input receptacle for receiving a stack of a mixed combination of currency bills and redeemable documents;

> a plurality of output receptacles for receiving currency bills and redeemable documents after the currency bills and the redeemable documents have been evaluated;

> a transport mechanism for transporting the currency bills and redeemable documents, one at a time, from the stack in the input receptacle to selected ones of the plurality of output receptacles along a transport path;

> an evaluation unit comprising a detector disposed along the transport path between the input receptacle and the output receptacle, the detector being configured to detect characteristic information associated with a currency bill and characteristic information associated with a redeemable document, the evaluating unit being configured to distinguish currency bills from redeemable documents and to distinguish valid redeemable documents from invalid redeemable documents . . .

As described previously, the Examiner has failed to establish sufficient grounds for these provisional and non-provisional double patenting rejections of the claims, because the Examiner has not provided a proper comparison of the claims as required and has failed to offer a reasoned, fact-based explanation supported by the evidence of record to justify the rejections. *See*, e.g., *Ex parte Whalen II*, Appeal 2007-4423 (B.P.A.I., July 23, 2008) (requiring a reasoned, fact-based explanation supported by the evidence of record).

Accordingly, the reversal of the double patenting rejection of claims 1-6, 11, 12, 15, 17-20, 22-29, 33, 35, 36, 38-40, 49-56, 59, 65, 68, 79, 80, 87, and 89 in view of U.S. Patent No. 7,103,438 is in order and is respectfully requested. Applicants note that dependent claims 69 and 70, which the Examiner rejected, were previously withdrawn.

3. **U.S. Patent No. 7,201,320 fails to provide sufficient grounds for the double patenting rejection of claims 1-6, 11, 12, 15, 17-20, 22-29, 33, 35, 36, 38-40, 49-56, 59, 65, 68-70, 79, 80, 87, and 89.**

Turning to U.S. Patent No. 7,201,320, claims 1 and 6 of U.S. Patent No. 7,201,320 differ from the rejected claims of the present application. Claim 6 is dependent on claim 1. Independent claim 1 of U.S. Patent No. 7,201,320 recites patentably distinct element(s) that are not recited in the presently rejected claims such as:

> at least one imager for capturing an image of at least a portion of the substitute currency media and the currency bills, wherein the imager creates an image file from the captured image; and

> a controller for controlling the at least one media detector, currency detector and imager, wherein the controller further receives the image file and processes the image file for storage.

As described previously, the Examiner has failed to establish sufficient grounds for these provisional and non-provisional double patenting rejections of the claims, because the Examiner has not provided a proper comparison of the claims as required and has failed to offer a reasoned, fact-based explanation supported by the evidence of record to justify the rejections. *See*, e.g., *Ex parte Whalen II*, Appeal 2007-4423 (B.P.A.I., July 23, 2008) (requiring a reasoned, fact-based explanation supported by the evidence of record).

Accordingly, the reversal of the double patenting rejection of claims 1-6, 11, 12, 15, 17-20, 22-29, 33, 35, 36, 38-40, 49-56, 59, 65, 68, 79, 80, 87, and 89 in view of U.S. Patent No. 7,201,320 is in order and is respectfully requested. Applicants note that dependent claims 69 and 70, which the Examiner rejected, were previously withdrawn.

4. U.S. Patent No. 6,843,418 fails to provide sufficient grounds for the double patenting rejection of claims 1-6, 11, 12, 15, 17-20, 22-29, 33, 35, 36, 38-40, 49-56, 59, 65, 68-70, 79, 80, 87, and 89.

Turning to U.S. Patent No. 6,843,418, claims 1-69 of U.S. Patent No. 6,843,418 patently differ from the rejected claims of the present application. To begin with, claims 51-69 of this patent are method claims; and thus, the rejection is improper given the previous finding that the method claims of the present application are patentably distinct from the rejected apparatus/system claims. (*See* Office Action mailed December 8, 2004 (requiring election/restrictions.))

Additionally, as an example, independent claim 1 of U.S. Patent No. 6,843,418 recites patentably distinct element(s) that are not recited in the presently rejected claims such as:

> at least one of the substitute currency media having at least a first barcode pattern and a second barcode pattern disposed thereon; ...

> an evaluation unit comprising ... a first media detector ... being capable of detecting the first barcode pattern and the second barcode pattern ....

As an additional example independent claim 24 of U.S. Patent No. 6,843,418 recites patentably distinct element(s) that are not recited in the presently rejected claims such as:

> at least one of the substitute currency media including at least a first barcode pattern representative of a ticket number and a second barcode pattern representative of a value ...;

> an evaluation unit comprising ... a first media detector ... being capable of detecting the first barcode pattern and the second barcode pattern; ...

> a communications port coupled to the controller, the communications port being adapted to transmit at least one of the ticket number associated with the first barcode pattern and the value associated with the second barcode pattern.

As an additional example independent claim 27 of U.S. Patent No. 6,843,418 recites patentably distinct element(s) that are not recited in the presently rejected claims such as:

each of the substitute currency media including at least a first barcode pattern encoding a number and a second barcode pattern encoding a value associated with the number; . . .

an evaluation unit comprising at least one detector . . . capable of . . . decoding the number encoded in the first barcode pattern and the value encoded in the second barcode pattern on each of the substitute currency media, one of the substitute currency media on which a number and a value are decoded being termed a valid substitute currency medium, and a controller . . . including a memory, the memory being adapted to store the number and the value of each valid substitute currency medium decoded by the detector.

As an additional example independent claim 47 of U.S. Patent No. 6,843,418 recites

patentably distinct element(s) that are not recited in the presently rejected claims such as:

47. A document processing device in a system having a plurality of machines adapted to accept documents, the plurality of machines being coupled to an accounting system, the document processing device comprising: . . . each of the substitute currency media including at least a first barcode pattern encoding a number and a second barcode pattern encoding a value; . . .

an evaluation unit comprising at least one detector . . . capable of . . . decoding the number encoded in the first barcode pattern and the value encoded in the second barcode pattern on each of the substitute currency media, and a controller . . . being adapted to store the number and the value of each substitute currency medium to a file.

As described previously, the Examiner has failed to establish sufficient grounds for these provisional and non-provisional double patenting rejections of the claims, because the Examiner has not provided a proper comparison of the claims as required and has failed to offer a reasoned, fact-based explanation supported by the evidence of record to justify the rejections. *See*, e.g., *Ex parte Whalen II*, Appeal 2007-4423 (B.P.A.I., July 23, 2008) (requiring a reasoned, fact-based explanation supported by the evidence of record).

Accordingly, the reversal of the double patenting rejection of claims 1-6, 11, 12, 15, 17-20, 22-29, 33, 35, 36, 38-40, 49-56, 59, 65, 68, 79, 80, 87, and 89 in view of U.S. Patent No. 6,843,418 is in order and is respectfully requested. Applicants note that dependent claims 69 and 70, which the Examiner rejected, were previously withdrawn.

5. U.S. Patent No. 7,146,245 fails to provide sufficient grounds for the double patenting rejection of claims 1-6, 11, 12, 15, 17-20, 22-29, 33, 35, 36, 38-40, 49-56, 59, 65, 68-70, 79, 80, 87, and 89.

Turning to U.S. Patent No. 7,146,245, claims 1-24 of U.S. Patent No. 7,146,245 patently differ from the rejected claims of the present application. To begin with, claims 1-24 of this patent are method claims; and thus, the rejection is improper given the previous finding that the method claims of the present application are patentably distinct from the rejected apparatus/system claims. (*See* Office Action mailed December 8, 2004 (requiring election/restrictions.) Additionally, as an example, independent claim 1 of U.S. Patent No. 7,146,245 recites patentably distinct element(s) that are not recited in the presently rejected claims such as:

> 1. A method of processing at least two batches of documents, comprising the acts of:
>
> receiving the at least two batches of documents;
>
> entering into memory of a document processing device source identification information for the at least two batches in a sequence;
>
> loading the at least two batches into the document processing device for multiple batch processing in a sequence consistent with the sequence in which the source identification information was entered into memory;
>
> after entering the source identification information for the at least two batches into memory, begin transporting the batches in a sequence consistent with the sequence in which the source identification information was entered into memory, one document at a time, through the document processing device to obtain characteristic information from the documents in the at least two batches, pausing the transport between each batch;
>
> determining the batch information for each of the at least two batches based on the obtained characteristic information; and
>
> matching on a sequential basis the batch information for each of the at least two batches with the source identification information for each of the at least two batches.

As described previously, the Examiner has failed to establish sufficient grounds for these provisional and non-provisional double patenting rejections of the claims, because the Examiner has not provided a proper comparison of the claims as required and has failed to offer a reasoned, fact-based explanation supported by the evidence of record to justify the rejections. *See*, e.g., *Ex parte Whalen II*, Appeal 2007-4423 (B.P.A.I., July 23, 2008) (requiring a reasoned, fact-based explanation supported by the evidence of record).

Accordingly, the reversal of the double patenting rejection of claims 1-6, 11, 12, 15, 17-20, 22-29, 33, 35, 36, 38-40, 49-56, 59, 65, 68, 79, 80, 87, and 89 in view of U.S. Patent No. 7,146,245 is in order and is respectfully requested. Applicants note that dependent claims 69 and 70, which the Examiner rejected, were previously withdrawn.

6. U.S. Patent No. 7,016,767 fails to provide sufficient grounds for the double patenting rejection of claims 1-6, 11, 12, 15, 17-20, 22-29, 33, 35, 36, 38-40, 49-56, 59, 65, 68-70, 79, 80, 87, and 89.

Turning to U.S. Patent No. 7,016,767, claims 14, 19, 20, 31, and 41-47 of U.S. Patent No. 7,016,767 differ from the rejected claims of the present application. To begin with, claims 14, 19, 20, and 31 of this patent are method claims; and thus, the rejection is improper given the previous finding that the method claims of the present application are patentably distinct from the rejected apparatus/system claims. (*See* Office Action mailed December 8, 2004 (requiring election/restrictions.)

Additionally, as an example, independent claim 14 of U.S. Patent No. 7,016,767 recites patentably distinct element(s) that are not recited in the presently rejected claims such as:

> 14. A method of processing at least two batches of documents, comprising the acts of:
>
> loading the at least two batches into a document processing device for multiple batch processing;

starting transportation of the batches in a sequence, ...

after the act of determining batch information for each of the at least two batches, entering source identification for each batch into memory in a sequence consistent with the sequence in which the at least two batches were transported through the document processing device; and

matching on a sequential basis the batch information for each of the at least two batches with the source identification information for each of the at least two batches.

As another example, independent claim 41 of U.S. Patent No. 7,016,767 recites

patentably distinct element(s) that are not recited in the presently rejected claims such as:

41. A document processing device for multiple batch processing comprising:

an input receptacle adapted to hold at least two batches of documents; ...

memory coupled to the evaluation unit adapted to store batch document information for each of the at least two batches based on processing the documents, and being adapted to store source identification information for each of the at least two batches;

a bar code gun coupled to the memory for entering the source identification information into memory; and

a controller coupled to the memory and comprising programming for:

allowing the source identification information for the at least two batches to be entered into memory before the at least two batches are transported past the evaluation unit, and sequentially stepping through the source identification information stored in memory to match batch document information with source identification information.

As described previously, the Examiner has failed to establish sufficient grounds for

these provisional and non-provisional double patenting rejections of the claims, because the

Examiner has not provided a proper comparison of the claims as required and has failed to

offer a reasoned, fact-based explanation supported by the evidence of record to justify the

rejections. *See*, e.g., *Ex parte Whalen II*, Appeal 2007-4423 (B.P.A.I., July 23, 2008)

(requiring a reasoned, fact-based explanation supported by the evidence of record).

Accordingly, the reversal of the double patenting rejection of claims 1-6, 11, 12, 15,

17-20, 22-29, 33, 35, 36, 38-40, 49-56, 59, 65, 68, 79, 80, 87, and 89 in view of U.S. Patent

No. 7,016,767 is in order and is respectfully requested. Applicants note that dependent claims 69 and 70, which the Examiner rejected, were previously withdrawn.

VIII. CONCLUSION

For all of the reasons discussed above, Appellants respectfully submit that all pending claims 1-6, 11, 12, 15, 17-20, 22-29, 33, 35, 36, 38-40, 49-56, 59, 65, 68, 79, 80, 87, and 89 define patentable subject matter. Accordingly, Appellants respectfully request that this Honorable Board reverse the rejections of claims 1-6, 11, 12, 15, 17-20, 22-29, 33, 35, 36, 38-40, 49-56, 59, 65, 68-70, 79, 80, 87, and 89.

Except for issue fees payable under 37 C.F.R. § 1.18, the Commissioner is hereby authorized by this paper to charge any additional fees during the entire pendency of this application including fees due under 37 C.F.R. §§ 1.16 and 1.17 which may be required, including any required extension of time fees, or credit any overpayment to Deposit Account No. 50-4181, Order No. 247171-000305USP1. If necessary, this paragraph is intended to be a **CONSTRUCTIVE PETITION FOR EXTENSION OF TIME** in accordance with 37 C.F.R. § 1.136(a)(3).

Dated: May 29, 2009   Respectfully submitted,

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INDEX TO THE APPENDICES

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CLAIM APPENDIX

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LIST OF EVIDENCE

IX.   CLAIMS APPENDIX

The following is a complete listing of claims in the application.

1.   (Previously Presented)   A funds processing system including at least one funds processing machine in which a user inputs currency bills and substitute funds, the at least one funds processing machine comprising:

   an input receptacle configured to receive a stack of a mixed combination of currency bills and substitute funds;

   a processing module coupled to the input receptacle and configured to receive the currency bills and substitute funds from the stack in the input receptacle and to process the currency bills and substitute funds, the processing module being configured to distinguish currency bills from substitute funds and valid substitute funds from invalid substitute funds; and

   a return receptacle coupled to the processing module and configured to return the substitute funds to the operator of the funds processing machine.

2.   (Original) The system of claim 1, wherein the substitute funds are casino script.

3.   (Original) The system of claim 1, wherein the substitute funds are paper tokens.

4.   (Original) The system of claim 1, wherein the substitute funds are bar coded tickets.

5.   (Previously Presented)   The system of claim 1, wherein the processing module is configured to scan and count the currency bills and substitute funds at a high rate of speed.

6.   (Original) The system of claim 5, wherein the high rate of speed is at least 350 documents per minute.

7.   (Withdrawn) The system of claim 1 further comprising:

   a host system communicatively coupled to the at least one funds processing machine; and

   a casino gaming network communicatively coupled to the at least one funds processing machine and to the host system.

8-10.   (Cancelled)

11.   (Previously Presented)   A system for processing both currency bills and substitute currency media, the system including a document processing apparatus, the apparatus comprising:

an input receptacle configured to receive a stack of a mixed combination of currency bills and substitute currency media;

at least one output receptacle configured to receive currency bills and substitute currency media after the currency bills and substitute currency media have been evaluated;

a transport mechanism configured to transport the currency bills and substitute currency media, one at a time, from the stack in the input receptacle to the at least one output receptacle along a transport path;

an evaluation unit comprising at least one currency detector disposed along the transport path between the input receptacle and the output receptacle, the at least one currency detector being capable of evaluating currency bills, and a first media detector disposed along the transport path between the input receptacle and the output receptacle, the first media detector being capable of evaluating substitute currency media, the evaluating unit being configured to distinguish currency bills from substitute currency media and to distinguish valid substitute currency media from invalid substitute currency media; and

a controller coupled to the evaluation unit, the controller being configured to control the operation of the transport mechanism and the operation of the evaluation unit.

12.   (Original)   The apparatus of claim 11 further comprising a communications port electrically coupled to the controller.

13.   (Withdrawn)   The system of claim 12 further comprising a coin sorting apparatus communicatively coupled to the communications port of the document processing apparatus, said coin sorting apparatus sorting and counting a plurality of coins into one or more coin hoppers, said coin sorting apparatus including communications means for communicating information associated with said counting of said plurality of coins.

14.   (Withdrawn)   The apparatus of claim 11 wherein the controller causes the transport mechanism to halt in response to the detection of a particular currency bill or substitute

currency medium that meets or fails to meet one or more criteria, wherein the halting causes the particular currency bill or substitute currency medium to be located at a predetermined position.

15.   (Original) The apparatus of claim 11 wherein the controller flags a currency bill or substitute currency medium meeting or failing to meet one or more criteria, the currency bill or substitute currency medium meeting or failing to meet one or more criteria being termed a flagged document, the apparatus further comprising a routing interface comprising a data retrieval device, the data retrieval device receiving information from a user of the apparatus specifying a set of one or more output receptacles to which flagged documents are to be directed.

16.   (Withdrawn) The apparatus of claim 15 further comprising a control unit coupled to the controller, the control unit including denomination keys, each of the denomination keys being associated with a different amount of currency, the selection of one of the denomination keys causing the associated amount of currency to be added to a running total amount of currency processed by the device.

17.   (Previously Presented) The apparatus of claim 11 further comprising a control unit coupled to the controller, the control unit being configured to receive information from a user of the apparatus and to display information to a user of the apparatus.

18.   (Previously Presented) The apparatus of claim 17, wherein the information displayed to a user includes characteristic information detected by the first media detector from a substitute currency medium.

19.   (Original) The apparatus of claim 18, wherein the characteristic information includes the value associated with a substitute currency medium.

20.   (Previously Presented) The apparatus of claim 18, wherein the substitute currency media are barcoded tickets having a barcode disposed thereon, each barcoded ticket having a ticket number, the displayed characteristic information including the ticket number of the barcoded ticket detected by the first media detector.

21.   (Withdrawn)   The apparatus of claim 17 wherein the control unit includes a touch screen.

22.   (Original)   The apparatus of claim 17 wherein the control unit includes a video display.

23.   (Original)   The apparatus of claim 11 wherein the evaluation unit evaluates the currency bills and substitute currency media at a rate of at least about 1000 documents per minute.

24.   (Original)   The apparatus of claim 11 wherein the evaluation unit evaluates the currency bills and substitute currency media at a rate of at least about 1500 documents per minute.

25.   (Previously Presented)   The apparatus of claim 11 further comprising a document facing mechanism coupled to said evaluation unit, said document facing mechanism being configured to rotate the orientation of the substitute currency media in one direction.

26.   (Previously Presented)   The apparatus of claim 11 further comprising a second media detector disposed along the transport path and proximate the at least one currency detector, wherein the first media detector is configured to detect at least one characteristic of a first type of substitute currency media and the second media detector is configured to detect at least one characteristic of a second type of substitute currency media, the first type of substitute currency media being different from the second type of substitute currency media.

27.   (Previously Presented)   The apparatus of claim 26, wherein the first type of substitute currency media includes a barcode encoded according to a first barcode symbology and wherein the first media detector is configured to read a barcode encoded according to the first barcode symbology.

28.   (Previously Presented)   The apparatus of claim 27, wherein the second type of substitute currency media includes a barcode encoded according to a second barcode symbology and wherein the second media detector is configured to read a barcode encoded according to the second barcode symbology.

29.   (Original) The apparatus of claim 11 further comprising a second media detector capable of evaluating substitute currency media, the first media detector and the second media detector being disposed on opposite sides of the transport path so as to be disposed adjacent to first and second opposing surfaces of the currency bills or substitute currency media passing along the transport path.

30.   (Withdrawn) The apparatus of claim 11 wherein the at least one output receptacle is exactly one output receptacle.

31.   (Withdrawn) The apparatus of claim 11 wherein the at least one output receptacle is exactly two output receptacles.

32.   (Withdrawn) The apparatus of claim 11 wherein the at least one output receptacle is at least eight output receptacles.

33.   (Original) The apparatus of claim 11, wherein the media detector includes a barcode reader.

34.   (Withdrawn) The apparatus of claim 33 further comprising memory means for storing information associated with at least one barcode identified by the barcode reader.

35.   (Original) The apparatus of claim 33 further comprising a mirror proximate the barcode reader, the mirror being positioned to deflect a light beam outputted from the barcode reader onto the surface of a document being transported along the transport path.

36.   (Previously Presented) The apparatus of claim 33, wherein the substitute currency media have a barcode pattern disposed on at least one surface thereof, and wherein the controller is configured to convert an electrical signal generated by the barcode reader into a set of characters, the electrical signal being generated in response to the scanning of a valid barcode pattern.

37.   (Withdrawn –Previously Presented) The apparatus of claim 36 further comprising:

          a memory coupled to the controller, the memory being configured to store at least a first set of characters provided by the controller; and

          a communications port coupled to the controller, the communications port being configured to transmit the at least first set of characters.

38.   (Previously Presented)   The apparatus of claim 11 wherein the currency detector is configured to detect at least one characteristic of a currency bill.

39.   (Original) The apparatus of claim 38, wherein the at least one characteristic is one of size, thickness, color, magnetism, reflectivity, absorbability, transmissivity, electrical conductivity, and serial number.

40.   (Original) The apparatus of claim 38, wherein the at least one detection means is an optical scan head.

41.   (Withdrawn) The apparatus of claim 38, wherein the at least one detection means is a magnetic sensor.

42.   (Withdrawn) The apparatus of claim 38, wherein the at least one detection means is a size detection sensor.

43.   (Withdrawn) The apparatus of claim 38, wherein the at least one detection means is a density sensor.

44.   (Withdrawn) The apparatus of claim 38, wherein the at least one detection means is a thread sensor.

45.   (Withdrawn) The apparatus of claim 38, wherein the at least one detection means is an infrared sensor.

46.   (Withdrawn) The apparatus of claim 38, wherein the at least one detection means is an ultraviolet scan head.

47.   (Withdrawn) The apparatus of claim 38, wherein the at least one detection means is a fluorescent light scan head.

48.   (Withdrawn) The apparatus of claim 38, wherein the at least one detection means is a full image scanner.

49.   (Previously Presented)   The apparatus of claim 33, wherein the substitute currency media are barcoded media having a barcode on at least one surface thereof.

50.   (Original) The apparatus of claim 49, wherein the barcode is a linear barcode.

51.   (Original) The apparatus of claim 49, wherein the barcoded media are casino script.

52.   (Original) The apparatus of claim 49, wherein the barcoded media are casino cashout tickets.

53.   (Original) The apparatus of claim 49, wherein the barcoded media are retailer coupons.

54.   (Original) The apparatus of claim 49, wherein the barcoded media are gift certificates.

55.   (Original) The apparatus of claim 49, wherein the barcoded media have substantially the same dimensions as U.S. currency bills.

56.   (Previously Presented) A system adapted to rapidly count and evaluate currency bills and barcoded media, the barcoded media having a barcode disposed on at least one surface thereof, the system comprising:

an input receptacle configured to receive a stack of documents, the documents including a mixed combination of currency bills and barcoded media;

at least one output receptacle configured to receive at least a portion of the stack of documents after the documents have been evaluated;

a transport mechanism configured to transport the documents, one at a time, from the stack in the input receptacle to the at least one output receptacle along a transport path;

an evaluation unit including a first sensor disposed along the transport path between the input receptacle and the output receptacle, the first sensor being configured to detect at least one characteristic of a currency bill, and a first barcode reader disposed along the transport path between the input receptacle and the output receptacle, the barcode reader being configured to scan a barcode; and

a controller coupled to the evaluation unit, the controller being configured to control the operation of the transport mechanism and the operation of the evaluation unit.

57.   (Withdrawn – Previously Presented) The system of claim 56, wherein the first barcode reader is configured to scan at least 500 barcodes per minute.

58.   (Withdrawn – Previously Presented)   The system of claim 56, wherein the first barcode reader is configured to scan at least 1000 barcodes per minute.

59.   (Previously Presented)   The system of claim 56, wherein the first barcode reader is configured to output an electrical signal representing a barcode symbol, the controller being configured to convert the electrical signal into a barcode number.

60.   (Withdrawn – Previously Presented)   The system of claim 59 further comprising memory coupled to the controller, the memory being configured to store the barcode number.

61.   (Withdrawn – Previously Presented)   The system of claim 59 further comprising a communications port coupled to the controller, the communications port being configured to communicatively link the controller to a computer network.

62.   (Withdrawn)   The system of claim 61, wherein the computer network is a casino gaming machine network.

63.   (Withdrawn)   The system of claim 61, wherein the computer network is a retailer network.

64.   (Withdrawn – Previously Presented)   The system of claim 62, wherein the controller is configured to retrieve a monetary amount associated with the barcode number from the casino gaming machine network.

65.   (Previously Presented)   The system of claim 56 further comprising a control unit coupled to the controller, the control unit being configured to display the number of barcoded media processed by the apparatus.

66.   (Withdrawn)   The system of claim 65, wherein the control unit is a touch panel display.

67.   (Withdrawn)   The system of claim 65, wherein said control unit is a touch/video display.

68.   (Previously Presented)   The system of claim 59 further comprising a control unit coupled to the controller, the control unit being configured to display the barcode number.

69.   (Withdrawn – Previously Presented) The system of claim 64, wherein the controller is configured to add the monetary amount associated with the barcode number to a running total.

70.   (Withdrawn) The system of claim 69, wherein the running total includes the monetary value of at least one currency bill evaluated by the evaluation unit.

71.   (Withdrawn) The system of claim 56 further comprising a second barcode reader coupled to the controller, the first barcode reader and the second barcode reader being disposed on opposite sides of the transport path.

72.   (Withdrawn – Previously Presented) The system of claim 56 further comprising a printer coupled to the controller, the controller being configured to generate a report, the report including the total amount of authentic currency bills processed from the stack of documents and the total number of substitute currency media processed from the stack of documents, the printer being configured to print at least a portion of the report.

73.   (Withdrawn – Previously Presented) The system of claim 56 further comprising a printer coupled to the controller, the printer being configured to dispense a barcoded ticket to a user of the device.

74.   (Withdrawn) The system of claim 73, wherein the barcoded ticket includes a barcode associated with the total amount of currency bills and substitute currency media processed by the device.

75.   (Withdrawn) The system of claim 56 wherein the at least one output receptacle is exactly one output receptacle.

76.   (Withdrawn) The system of claim 56 wherein the at least one output receptacle is exactly two output receptacles.

77.   (Withdrawn) The system of claim 56 wherein the at least one output receptacle is at least eight output receptacles.

78.   (Withdrawn) The system of claim 56, wherein the barcode reader has a height of about 3 inches, a width of about 2.13 inches, and a depth of about 1.63 inches.

79. (Previously Presented) A document processing apparatus for processing a stack of currency bills and barcoded media, comprising:

an input receptacle configured to receive a stack of documents including a mixed combination of currency bills of mixed denominations and barcoded media;

a plurality of output receptacles each configured to receive at least a portion of the stack of documents;

a transport mechanism configured to transport the currency bills and barcoded media, one at a time, from the stack in the input receptacle to one of the plurality of output receptacles;

an evaluation unit disposed along the transport path between the input receptacle and the plurality of output receptacles, the evaluation unit comprising at least one currency sensor and a barcode reader positioned adjacent the transport path, the at least one currency sensor being configured to obtain denomination characteristic information of a first currency bill, the barcode reader being configured to scan for a barcode on a document from the stack of documents passing along the transport path, a document on which the barcode reader detects a barcode being termed a valid barcoded medium, a document on which the barcode reader does not detect a barcode being termed an invalid barcoded medium;

a controller coupled to the evaluation unit, the controller being programmable for directing currency bills having a first denomination to a specified first output receptacle of the plurality of output receptacles, and for directing a barcoded media having a valid barcode disposed thereon to a specified second output receptacle of the plurality of output receptacles; and

a memory electrically coupled to the controller, the memory being configured to store the denominations of the currency bills and the characters associated with barcodes on barcoded media.

80. (Previously Presented) The apparatus of claim 79, wherein the at least one currency sensor is further configured to obtain authenticating characteristic information of a currency bill, the controller being configured to compare the authenticating characteristic information with master authenticating information stored in a memory, the controller being further configured to compare the denomination characteristic information with master denomination

information stored in a memory, wherein currency bills whose authenticating characteristic information satisfies a predetermined relationship with the master authenticating information are termed authentic bills, currency bills whose authenticating characteristic information does not satisfy a predetermined relationship with the master authenticating information are termed suspect bills, and currency bills whose denomination characteristic information does not satisfy a predetermined relationship with the master denomination characteristic information are termed no call bills.

81.   (Withdrawn – Previously Presented) The apparatus of claim 80, wherein the controller is configured to direct no call bills to a specified third output receptacle of the plurality of output receptacles.

82.   (Withdrawn – Previously Presented) The apparatus of claim 80, wherein the controller is configured to direct suspect bills to a specified third output receptacle of the plurality of output receptacles.

83.   (Withdrawn – Previously Presented) The apparatus of claim 80, wherein the controller is configured to direct no call bills to a specified third output receptacle of the plurality of output receptacles and to direct suspect bills to a specified fourth output receptacle of the plurality of output receptacles.

84.   (Withdrawn – Previously Presented) The apparatus of claim 80, wherein the controller is configured to direct no call bills and suspect bills to a specified third output receptacle.

85.   (Withdrawn – Previously Presented) The apparatus of claim 80, wherein the controller is configured to direct invalid barcoded media to a specified third output receptacle.

86.   (Withdrawn – Previously Presented) The apparatus of claim 80, wherein the controller is configured to direct invalid barcoded media to the specified second output receptacle.

87.   (Previously Presented) A document processing apparatus adapted to process currency bills and substitute currency media, the apparatus comprising:

an input receptacle configured to receive a stack of documents including a mixed combination of currency bills and substitute currency media, the substitute currency media being redeemable documents;

at least one output receptacle configured to receive at least a portion of the documents after the portion of the documents have been evaluated;

a transport mechanism configured to transport the documents, one at a time, from the stack in the input receptacle to the at least one output receptacle along a transport path;

an evaluation unit comprising a first scanner disposed along the transport path between the input receptacle and the output receptacle, the first scanner being capable of scanning for at least one characteristic associated with a currency bill, the evaluation unit further comprising a second scanner capable of scanning for at least one characteristic associated with a substitute currency medium, the evaluating unit being configured to distinguish currency bills from substitute currency media and to distinguish valid substitute currency media from invalid substitute currency media; and

a controller coupled to the evaluation unit, the controller being configured to control the operation of the transport mechanism and the operation of the evaluation unit.

88.   (Withdrawn – Previously Presented) A document processing apparatus for processing both currency bills and substitute currency media, the apparatus comprising:

an input receptacle for receiving currency bills and substitute currency media;

a plurality of output receptacles for receiving currency bills and substitute currency media after the currency bills and substitute currency media have been evaluated;

a transport mechanism for transporting the currency bills and substitute currency media, one at a time, from the input receptacle to one of the plurality of output receptacles along a transport path;

an evaluation unit comprising a scanhead disposed along the transport path between the input receptacle and the output receptacle, the scanhead comprising a sensor for evaluating the currency bills and a barcode reader for evaluating the substitute currency media;

a controller coupled to the evaluation unit, the controller controlling the operation of the transport mechanism and the operation of the evaluation unit; and

an interface coupled to the controller, the interface being configured to receive instructions from an operator of the apparatus specifying one or more of the plurality of output receptacles to which currency bills and substitute currency media are to be directed.

89.   (Previously Presented)   A document processing apparatus for processing both currency bills and redeemable documents, the apparatus comprising:

an input receptacle for receiving a stack of a mixed combination of currency bills and redeemable documents;

a plurality of output receptacles for receiving currency bills and redeemable documents after the currency bills and the redeemable documents have been evaluated;

a transport mechanism for transporting the currency bills and redeemable documents, one at a time, from the stack in the input receptacle to selected ones of the plurality of output receptacles along a transport path;

an evaluation unit comprising a detector disposed along the transport path between the input receptacle and the output receptacle, the detector being configured to detect characteristic information associated with a currency bill and characteristic information associated with a redeemable document, the evaluating unit being configured to distinguish currency bills from redeemable documents and to distinguish valid redeemable documents from invalid redeemable documents; and

a controller coupled to the evaluation unit, the controller controlling the operation of the transport mechanism and the operation of the evaluation unit.

90-111.   (Cancelled)

11046026.1

X.   EVIDENCE APPENDIX

A copy of the evidence relied upon by the appellant is included in the Evidence Appendix. A list of evidence and where each was entered in the record is included in the Index to the Appendices.

XI.   RELATED PROCEEDINGS APPENDIX

As there are no related proceedings, no information is provided in the Related Proceedings Appendix.